

O P E R A T I O N S
SEP 25 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#17/Appeal
Brief
10/24/03
Rowan
1/3

Inventor	Philip F. Fox	Appeal No.	
Appln. No.	701	Group Art Unit:	3643
Filed	February 11, 2000	Examiner:	K. Rowan
Title	ICE FISHING TACKLE STORAGE APPARATUS		
Docket No.	F351.12-0001		

BRIEF FOR APPELLANT

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SENT VIA EXPRESS MAIL
Express Mail No.: EV 302261259

RECEIVED

Oct 02 2003

GROUP 3600

Sir:

This is an appeal from an Office Action dated March 25, 2003 in which the Examiner finally rejected all of the claims present in the above-identified application, namely claims 1-43.

REAL PARTY IN INTEREST

The real party in interest in this Appeal is Mr. Philip F. Fox, who is the owner of the entire right, title, and interest in the above-identified application.

RELATED APPEALS AND INTERFERENCES

There are no known related appeals or interferences involving the subject matter or issues in this Appeal, and there are no known related appeals or interferences that will directly affect, be directly affected by, or have a bearing on the Board's decision in this Appeal.

STATUS OF THE CLAIMS

A. TOTAL NUMBER OF CLAIMS IN THE APPLICATION

Claims in the application are: Claims 1-43.

000000021 09502701
000000021 5555E1
000000021 09502701
000000021 5555E1
160.00 UP
01 70-2402
01 70-2402

B. STATUS OF ALL THE CLAIMS

1. Claims canceled:
None.
2. Claims withdrawn from consideration, but not canceled:
None.
3. Claims pending:
Claims 1-43.
4. Claims allowed:
None.
5. Claims rejected:
Claims 1-43.

C. CLAIMS ON APPEAL

1. The claims on appeal are: Claims 1-43.

STATUS OF AMENDMENTS

No amendments were submitted after the Final Rejection contained in the Office Action dated March 25, 2003.

SUMMARY OF INVENTION

Claim 1 defines an ice fishing tackle storage apparatus. The apparatus of claim 1 comprises a pair of extendable elongate shells and a spacing structure. According to claim 1, the extendable elongate shells have an interior surface that defines an elongate cavity, and the pair of extendable elongate shells are located adjacent to each other. Claim 1 specifies that the pair of extendable elongate shells are each secured by the spacing structure that is effective to maintain the pair of extendable elongate shells in predetermined relation to each other, proximate the spacing structure. Finally, claim 1 specifies that ice fishing tackle is capable of being positioned within the

elongate cavity of each extendable elongate shell. See page 4, line 4 through page 5, line 2; Figure 3 (as amended in Amendment After Final filed on May 6, 2002); Figure 4; page 6, lines 22-27; page 8, line 14, through page 9, line 2; page 10, lines 5-11; page 10, lines 12-25 (as amended in Amendment After Final filed on May 6, 2002); and original claim 1.

Claim 2 depends from independent claim 1 and specifies that the spacing structure of the ice fishing tackle storage apparatus comprises a first template, where the first template comprises a plurality of interior surfaces. According to claim 2, the interior surfaces define a plurality of apertures that extend through the first template. Furthermore, claim 2 requires that each extendable elongate shell defined in claim 1 passes through one of the apertures of the first template. See page 4, lines 4-10; Figure 1; page 4, line 27, through page 5, line 12; and Figure 3 (as amended in Amendment After Final filed on May 6, 2002).

Claim 3 depends from dependent claim 2 and specifies that the spacing structure of the ice fishing tackle storage apparatus further comprises a second template, where the second template comprises one or more interior surfaces. According to claim 3, the interior surface(s) of the second template define(s) at least one aperture that extends through the second template. Furthermore, claim 3 requires that one of the extendable elongate shells defined in claims 1 and 2 pass through the aperture of the second template. See page 4, line 4, through page 5, line 12, and Figure 3 (as amended in Amendment After Final filed on May 6, 2002).

Claim 4 depends from independent claim 1 and specifies that the ice fishing tackle storage apparatus of claim 1 is positioned in a container. Claim 4 specifies that the container has a wall that comprises interior surfaces defining either (1) a plurality of recesses in the wall or (2) a plurality of apertures through the wall. According to claim 4, the spacing structure defined in claim 1 comprises the recesses or the apertures of the wall, where each extendable elongate shell defined in claim 1 either (1) passes through the apertures of the wall or (2) is positioned in the recesses of

the wall. See page 3, line 26, through page 4, line 1; Figure 1; page 13, lines 3-14; Figure 8 (as amended in Amendment filed on August 15, 2001); and original claim 4.

Claim 5 depends from independent claim 1 and specifies that the ice fishing tackle storage apparatus of claim 1 is positioned in a container, where the container has a wall. Claim 5 specifies that the spacing structure comprises a plurality of sockets, where the sockets are attached to the wall of the container and the extendable elongate shells defined in claim 1 are positioned in the sockets. See page 3, line 26, through page 4, line 1; Figure 1; page 13, lines 3-14; Figure 8 (as amended in Amendment filed on August 15, 2001); and original claim 5.

Claim 6 depends from independent claim 1 and specifies that the ice fishing tackle storage apparatus of claim 1 is positioned in a container. Claim 6 specifies that the container has a wall with a proximal end, a distal end, and an interior surface. According to claim 6, the spacing structure defined in claim 1 is either (1) in contact with the proximal end of the wall, (2) in contact with the interior surface of the wall, or (3) in contact with both the proximal end of the wall and the interior surface of the wall. See page 3, line 26, through page 4, line 1; Figure 1; page 4, lines 20-26; and Figure 3 (as amended in Amendment After Final filed on May 6, 2002).

Claim 7 depends from independent claim 1 and specifies that at least one of the extendable elongate shells has a longitudinal axis, comprises a female elongate shell, and comprises a male elongate shell that is positioned within the female elongate shell. According to claim 7, either (1) the male elongate shell is selectively movable along the longitudinal axis relative to the female elongate shell or (2) the female elongate shell selectively movable along the longitudinal axis relative to the male elongate shell. See page 9, lines 9-27, and Figure 4.

Claim 8 depends from dependent claim 7 and specifies that the female elongate shell defined in claim 7 and the male elongate shell defined in claim 7 are each tubes. See page 4, lines 27-28; Figure 2; and Figure 3 (as amended in Amendment After Final filed on May 6, 2002).

Claim 9 depends from dependent claim 7 and specifies that the female elongate shell defined in claim 7 and the male elongate shell defined in claim 7 each have a cross-sectional shape.. The cross-sectional shape of the female elongate shell may be cylindrical, square, rectangular, triangular, or elliptical. Likewise, the cross-sectional shape of the male elongate shell may be cylindrical, square, rectangular, triangular, or elliptical. See page 7, lines 9-13; Figure 5; and original claim 9.

Claim 10 defines an ice fishing tackle storage apparatus. The apparatus of claim 10 comprises a pair of elongate shells, a first spacing component, and a second spacing component that is spaced apart from the first spacing component. According to claim 10, the elongate shells each have an interior surface that defines an elongate cavity, and the pair of elongate shells are located adjacent to each other. Claim 10 specifies that the pair of elongate shells are each secured by the first spacing component and further specifies that at least one of the elongate shells is secured by the second spacing component. Claim 10 also requires that at least one of the elongate cavities has a length that is adequate to accept a portion of an ice fishing rod. Claim 10 describes the ice fishing rod as having a tip and a handle, where a reel or a line windup is attached to the ice fishing rod proximate the handle. According to claim 10, the portion (that at least one of the elongate cavities has a length adequate to accept) of the ice fishing rod extends from the tip of the ice fishing rod to either the reel or the line windup. See page 4, lines 4-9; page 4, line 17, through page 5, line 2; Figure 3 (as amended in Amendment After Final filed on May 6, 2002); page 6, lines 19-22; page 8, line 14, through page 9, line 2; page 10, lines 5-11; page 10, lines 12-25 (as amended in Amendment After Final filed on May 6, 2002); and original claim 10.

Claim 11 depends from independent claim 10 and specifies that the ice fishing tackle storage apparatus of claim 10 is positioned in a container. Claim 11 specifies that the container has a wall with a proximal end, a distal end, and an interior surface. According to claim 11, the first spacing component defined in claim 10 is either (1) in contact with the proximal end of the wall, (2) in contact with the interior surface of the wall, or (3) in contact with both the proximal end of the

wall and the interior surface of the wall. See page 3, line 26, through page 4, line 1; Figure 1; page 4, lines 20-26; and Figure 3 (as amended in Amendment After Final filed on May 6, 2002).

Claim 12 depends from dependent claim 11 and specifies that the second spacing component defined in claim 10 is in contact with the interior surface of the wall defined in claim 11. See page 4, lines 24-26, and Figure 3 (as amended in Amendment After Final filed on May 6, 2002).

Claim 13 depends from independent claim 10 and specifies that the first spacing structure of the ice fishing tackle storage apparatus comprises a template, where the template comprises a plurality of interior surfaces. According to claim 13, the interior surfaces of the template define a plurality of apertures that extend through the template. Furthermore, claim 13 requires that each elongate shell defined in claim 10 passes through one of the apertures of the template. See page 4, lines 4-10; Figure 1; page 4, line 27, through page 5, line 12; and Figure 3 (as amended in Amendment After Final filed on May 6, 2002).

Claim 14 depends from independent claim 10 and specifies that the ice fishing tackle storage apparatus of claim 10 is positioned in a container. Claim 14 specifies that the container has a wall that comprises one or more interior surfaces defining either (1) a recess in the wall or (2) an aperture through the wall. According to claim 14, the second spacing component defined in claim 10 comprises the recess or the aperture of the wall, where one of the elongate shells defined in claim 10 either (1) passes through the aperture of the wall or (2) is positioned in the recess of the wall. See page 3, line 26, through page 4, line 1; Figure 1; page 13, lines 3-14; Figure 8 (as amended in Amendment filed on August 15, 2001); and original claim 14.

Claim 15 depends from independent claim 10 and specifies that the ice fishing tackle storage apparatus of claim 10 is positioned in a container, where the container has a wall. Claim 15 specifies that the ice fishing tackle storage apparatus comprises a socket, where the socket is attached to the wall of the container and one of the elongate shells defined in claim 10 is positioned in the

socket. See page 3, line 26, through page 4, line 1; Figure 1; page 13, lines 3-14; Figure 8 (as amended in Amendment filed on August 15, 2001); and original claim 5.

Claim 16 depends from independent claim 10 and specifies that each of the elongate shells has a longitudinal axis. According to claim 16, a length of at least one of the elongate shells is selectively and reversibly adjustable along the longitudinal axis of the at least one elongate shell. See page 9, lines 9-27; Figure 4; and original claim 15.

Claim 17 depends from independent claim 10 and specifies that the elongate shells defined in claim 10 each have a cross-sectional shape that may be cylindrical, square, rectangular, triangular, elliptical, or any of these cross sectional shapes in any combination. See page 7, lines 9-13; Figure 5; and original claim 17.

Claim 18 depends from independent claim 10. According to claim 18, a pair of the elongate shells defined in claim 10 are located adjacent to each other. Claim 18 specifies that either the first spacing component defined in claim 10 is effective to maintain the pair of elongate shells in predetermined relation to each other, proximate the first spacing component, or the second spacing component defined in claim 10 is effective to maintain the pair of elongate shells in predetermined relation to each other, proximate the second spacing component. See page 6, lines 4-7; Figure 3 (as amended in Amendment After Final filed on May 6, 2002); page 6, lines 13-27; page 8, line 14, though page 9, line 2; and original claim 18.

Claim 19 defines an ice fishing tackle storage apparatus. The apparatus of claim 19 comprises a plurality of elongate shells and a spacing structure. According to claim 19, the elongate shells each have an interior surface that defines an elongate cavity. Claim 19 specifies that the pair of elongate shells are each secured by the spacing structure that is effective to maintain two or more of the elongate shells in predetermined relation to each other, proximate the spacing structure. Claim 19 also specifies that ice fishing tackle is capable of being positioned within the elongate cavity of

each elongate shell. According to claim 19, at least two of the elongate shells are capable of serving as legs that will stably support the apparatus on a surface when the at least two elongate shells are positioned in contact with the surface. Finally, claim 19 specifies that the spacing structure is effective to prevent slippage of the at least two elongate shells with respect to the spacing structure. See page 4, lines 4-9; page 4, line 27, through page 5, line 2; Figure 3 (as amended in Amendment After Final filed on May 6, 2002); page 5, line 14, through page 6, line 3; page 6, lines 22-27; page 8, line 14, through page 9, line 2; page 10, lines 5-11; page 10, lines 12-25 (as amended in Amendment After Final filed on May 6, 2002); and original claim 19.

Claim 20 depends from independent claim 19 and specifies that the ice fishing tackle storage apparatus of claim 19 is positioned in a container. Claim 20 specifies that the container has a wall with a proximal end, a distal end, and an interior surface. According to claim 20, the spacing structure defined in claim 19 is either (1) in contact with the proximal end of the wall, (2) in contact with the interior surface of the wall, or (3) in contact with both the proximal end of the wall and the interior surface of the wall. See page 3, line 26, through page 4, line 1; Figure 1; page 4, lines 20-26; Figure 3 (as amended in Amendment After Final filed on May 6, 2002); and original claim 6.

Claim 21 depends from independent claim 19 and specifies that each of the elongate shells has a longitudinal axis. According to claim 21, a length of at least one of the elongate shells is selectively and reversibly adjustable along the longitudinal axis of the at least one elongate shell. See page 9, lines 9-27; Figure 4; and original claim 21.

Claim 22 depends from independent claim 19 and specifies that the elongate shells defined in claim 19 each have a cross-sectional shape that may be cylindrical, square, rectangular, triangular, elliptical, or any of these cross-sectional shapes in any combination. See page 7, lines 9-13; Figure 5; and original claim 22.

is spaced apart from the first spacing component. According to claim 30, the elongate shells each have an interior surface that defines an elongate cavity. Claim 30 specifies that the pair of elongate shells are each secured by the first spacing component. Finally, claim 30 states that ice fishing rods are capable of being individually positioned within the elongate cavities of the different elongate shells. See page 4, lines 4-9 and lines 17-26; page 4, line 27, through page 5, line 2; Figure 3 (as amended in Amendment After Final filed on May 6, 2002); page 6, lines 19-22; page 8, line 14, through page 9, line 2; page 10, lines 5-11; page 10, lines 12-25 (as amended in Amendment After Final filed on May 6, 2002); and original claim 10.

Claim 30 depends from independent claim 29 and specifies that ice fishing rods are capable of being individually positioned within the elongate cavities of the different elongate shells defined in claim 30 (1) with tips of the rods located within the elongate cavities and (2) with either (a) the reels or line windups of the ice fishing rods or (b) fishing line that extends from the reels or line windups being in contact with the elongate shells. See page 10, lines 12-25 (as amended in Amendment After Final filed on May 6, 2002) and Figure 3 (as amended in Amendment After Final filed on May 6, 2002).

Claim 32 defines an ice fishing tackle storage apparatus. The apparatus of claim 32 comprises a pair of elongate shells, a first spacing component, and a second spacing component that is spaced apart from the first spacing component. According to claim 32, the elongate shells each have an interior surface that defines an elongate cavity, where ice fishing tackle is capable of being positioned within the elongate cavities of each elongate shell. Claim 32 specifies that the pair of elongate shells are each secured by the first spacing component and further specifies that at least one of the elongate shells is secured by the second spacing component. Claim 32 also states that the ice fishing tackle storage apparatus is positioned in a container having a wall. According to claim 32, the wall comprises one or more interior surfaces that define either (1) a recess in the wall or (2) an aperture through the wall. Claim 32 states that the second spacing component comprises either the recess or the aperture. Finally, per claim 32, one of the elongate shells passes through the aperture

of the wall or is positioned in the recess of the wall. See page 3, line 26, through page 4, line 1; Figure 1; page 4, lines 4-9 and lines 17-26; page 4, line 27, through page 5, line 2; Figure 3 (as amended in Amendment After Final filed on May 6, 2002); page 6, lines 19-22; page 8, line 14, through page 9, line 2; page 10, lines 5-11; page 13, lines 3-14; Figure 8 (as amended in Amendment filed on August 15, 2001); and original claims 4, 10, and 14.

Claim 33 defines an ice fishing tackle storage apparatus. The apparatus of claim 33 comprises a pair of elongate shells, a first spacing component, and a second spacing component that is spaced apart from the first spacing component. According to claim 33, the elongate shells each have an interior surface that defines an elongate cavity, where ice fishing tackle is capable of being positioned within the elongate cavities of each elongate shell. Claim 33 specifies that the pair of elongate shells are each secured by the first spacing component and further specifies that at least one of the elongate shells is secured by the second spacing component. Claim 33 also states that the ice fishing tackle storage apparatus is positioned in a container having a wall. According to claim 33, the ice fishing tackle storage apparatus comprises a socket attached to the wall of the container, and one of the elongate shells is positioned in the socket. See page 3, line 26, through page 4, line 1; Figure 1; page 4, lines 4-9 and lines 17-26; page 4, line 27, through page 5, line 2; Figure 3 (as amended in Amendment After Final filed on May 6, 2002); page 6, lines 19-22; page 8, line 14, through page 9, line 2; page 10, lines 5-11; page 13, lines 3-14; Figure 8 (as amended in Amendment filed on August 15, 2001); and original claims 5 and 14.

Claim 34 defines an ice fishing tackle storage system that comprises an ice fishing storage apparatus, a first wall, and a container. The ice fishing storage apparatus of claim 34 comprises a pair of elongate shells and a first spacing component. According to claim 34, the elongate shells each have an interior surface that defines an elongate cavity, where ice fishing tackle is capable of being positioned within the elongate cavities of each elongate shell. Claim 34 specifies that the pair of elongate shells are each secured by the first spacing component and further states that the first wall is attached to the first spacing component. Claim 34 also states that the ice fishing

tackle storage apparatus is positioned in a container having a second wall. According to claim 34, the first wall and the second wall define a chamber within the container, and an ice fishing tip-up is capable of being placed in the chamber. See page 3, line 26, through page 4, line 3; Figure 1; page 4, lines 4-14 and lines 17-26; page 4, line 27, through page 5, line 2; Figure 3 (as amended in Amendment After Final filed on May 6, 2002); page 7, line 25, through page 8, line 2; page 10, lines 5-11; page 12, line 14, through page 13, line 2; Figure 6; and Figure 7.

Claim 35 depends from independent claim 34 and further specifies that the ice-fishing tip-up is capable of being entirely within the chamber. See page 10, lines 5-8 and lines 12-15; and page 12, lines 12-13.

Claim 36 defines an ice fishing tackle storage system that comprises a pair of elongate shells and a first spacing component. According to claim 36, the elongate shells each have an interior surface that defines an elongate cavity, where ice fishing tackle is capable of being positioned within the elongate cavities of each elongate shell. Claim 36 specifies that the pair of elongate shells are each secured by the first spacing component. Claim 36 also states that each elongate shell has a proximal end and a distal end. According to claim 36, the proximal end of each elongate shell has a rounded surface that is adequate to minimize abrasion of any fishing line that rests against the proximal end of any elongate shell. See page 3, line 26, through page 4, line 1; Figure 1; page 4, lines 4-9 and lines 17-26; page 4, line 27, through page 5, line 2; Figure 3 (as amended in Amendment After Final filed on May 6, 2002); page 6, lines 19-22; page 8, line 14, through page 9, line 2; page 10, lines 5-11; page 10, lines 12-25 (as amended in Amendment After Final filed on May 6, 2002); and original claim 10.

Claim 37 defines an ice fishing tackle storage apparatus. The apparatus of claim 37 comprises a pair of elongate shells, a first spacing component, and a second spacing component that is spaced apart from the first spacing component. According to claim 37, the elongate shells each have an interior surface that defines an elongate cavity, where ice fishing tackle is capable of being

positioned within the elongate cavities of each elongate shell. Claim 37 specifies that the pair of elongate shells are each secured by the first spacing component and further specifies that at least one of the elongate shells is secured by the second spacing component. Claim 37 also states that the ice fishing tackle storage apparatus is positioned in a container. According to claim 37, the container has a closed bottom end and an open upper end, and the first spacing component is positioned at the open upper end of the container. Finally, claim 37 states that the elongate shells each have both a distal end and a proximal end, and further states that the first spacing component has a distal surface and a proximal surface. See page 3, line 26, through page 4, line 3; Figure 1; page 4, lines 4-14 and lines 17-26; page 4, line 27, through page 5, line 13; Figure 3 (as amended in Amendment After Final filed on May 6, 2002); page 6, lines 19-22; page 7, lines 14-18; page 8, line 14, through page 9, line 2; page 9, lines 13-14; and original claim 4.

Claim 38 depends from independent claim 37 and specifies that the proximal end of at least one of the elongate shells is flush with the proximal surface of the first spacing component. See page 6, lines 25-27.

Claim 39 depends from independent claim 19 and specifies that the spacing structure is free of contact with the surface. See page 4, lines 21-24; page 6, lines 5-6; and Figure 3 (as amended in Amendment After Final filed on May 6, 2002).

Claim 40 depends from independent claim 19 and specifies that the spacing structure comprises a template. Per claim 40, the template comprises a plurality of interior surfaces and the interior surfaces define a plurality of apertures that extend through the template. Finally, claim 40 requires that at least one of the elongate shells must pass through one of the apertures of the template. See page 4, lines 4-9; page 5, lines 1-2; and Figure 3 (as amended in Amendment After Final filed on May 6, 2002).

Claim 41 depends from independent claim 23 and specifies that the spacing structure is free of contact with the surface. See page 4, lines 21-24; page 6, lines 5-6; and Figure 3 (as amended in Amendment After Final filed on May 6, 2002).

Claim 42 depends from independent claim 23 and specifies that the spacing structure comprises a template. Per claim 42, the template comprises a plurality of interior surfaces and the interior surfaces define a plurality of apertures that extend through the template. Finally, claim 42 requires that at least one of the elongate shells must pass through one of the apertures of the template. See page 4, lines 4-9; page 5, lines 1-2; and Figure 3 (as amended in Amendment After Final filed on May 6, 2002).

Claim 43 defines a bucket assembly. The bucket assembly of claim 43 comprises a bucket, a plurality of elongate shells, and a first spacing component. Claim 43 states that the bucket has a wall with a proximal end, a distal end, and an interior surface and has a water-holding capacity of at least about three gallons. According to claim 43, the elongate shells each have an interior surface that defines an elongate cavity, where ice fishing tackle is capable of being positioned within the elongate cavities of each elongate shell. Claim 43 further specifies that the elongate shells are each secured by the first spacing component. Finally, claim 43 requires that the first spacing component be (1) in contact with the proximal end of the wall, (2) in contact with the interior surface of the wall, or (3) in contact with both the proximal end of the wall and the interior surface of the wall. See page 3, line 26, through page 4, line 3; Figure 1; page 4, lines 4-9; page 4, lines 17-20; page 4, line 27, through page 5, line 2; Figure 3 (as amended in Amendment After Final filed on May 6, 2002); Figure 4; page 6, lines 22-27; page 7, lines 17-20; page 8, line 14, through page 9, line 2; page 10, lines 5-11; page 10, lines 12-25 (as amended in Amendment After Final filed on May 6, 2002); page 13, lines 3-14; Figure 8 (as amended in Amendment filed on August 15, 2001); and original claims 1 and 4.

ISSUES

- I. One issue is whether claims 1-2, 7-9, and 24-27 are anticipated under 35 U.S.C. §102(e) by U.S. Patent No. 6,185,860 to Thibodeaux (the “Thibodeaux patent”).
- II. Another issue is whether claims 10-15, 17-18, 30-34, and 37-38 are anticipated under 35 U.S.C. §102(b) by U.S. Patent No. 4,827,658 to Wolniak (the “Wolniak patent”).
- III. Another issue is whether claims 19, 21-23, 39, and 41 are anticipated under 35 U.S.C. §102(b) by U.S. Patent No. 5,131,179 to McEwen (the “McEwen patent”).
- IV. Another issue is whether claim 3 is obvious under 35 U.S.C. §103 in view of the Thibodeaux patent as applied to claim 1, and further in view of U.S. Patent No. 4,311,262 to Morin (the “Morin patent”).
- V. Another issue is whether claims 27-29 are obvious under 35 U.S.C. §103 in view of the Thibodeaux patent.
- VI. Another issue is whether claims 1, 4-6, 16, and 43 are obvious under 35 U.S.C. §103 considering the Wolniak patent in view of the Thibodeaux patent.
- VII. Another issue is whether claim 20 is obvious under 35 U.S.C. §103 considering the McEwen patent.
- VIII. Another issue is whether claims 35-36 are obvious under 35 U.S.C. §103 considering the Wolniak patent.

Claim 23 defines an ice fishing tackle storage apparatus. The apparatus of claim 23 comprises a plurality of elongate shells, a spacing structure, and a plurality of legs. According to claim 23, the elongate shells each have an interior surface that defines an elongate cavity. Claim 23 specifies that the elongate shells are each secured by the spacing structure that is effective to maintain at least two of the elongate shells in predetermined relation to each other, proximate the spacing structure. Claim 23 also specifies that ice fishing tackle is capable of being positioned within the elongate cavities of the elongate shells. According to claim 23, at least two of the elongate shells are capable of serving as legs that will stably support the apparatus on a surface when the at least two elongate shells are positioned in contact with the surface. Finally, claim 23 specifies that the plurality of legs are attached to the spacing structure or to any of the elongate shells and further specifies that the plurality of legs are capable of supporting the apparatus on a surface when the legs are positioned in contact with the surface. See page 4, lines 4-9; page 4, line 27, through page 5, line 2; Figure 3 (as amended in Amendment After Final filed on May 6, 2002); page 5, line 14, through page 6, line 3; page 6, lines 22-27; page 8, line 14, through page 9, line 2; page 10, lines 5-11; page 10, lines 12-25 (as amended in Amendment After Final filed on May 6, 2002); and original claim 23.

Claim 24 depends from independent claim 1 and specifies that the pair of extendable elongate shells defined in claim 1 comprise a first extendable elongate shell and a second extendable elongate shell. According to claim 24, the first extendable elongate shell has a first interior surface that defines a first elongate cavity and the second extendable elongate shell has a second interior surface that defines a second elongate cavity. Claim 24 specifies that first extendable elongate shell comprises a plurality of separable elongate shell components, where each elongate shell component has an inner surface that defines an elongate cavity portion. Claim 24 further specifies that the elongate cavity portions of each adjacent elongate shell component are in communication with each other. Finally, claim 24 specifies that the elongate cavity portions collectively form the first elongate cavity. See page 9, lines 9-18; Figure 4; page 10, lines 1-2 and lines 8-11; and page 10, line 26, through page 11, line 15.

Claim 25 depends from independent claim 1 and specifies that each elongate cavity is selectively and reversibly capable of being lengthened or shortened. See page 9, lines 25-27; page 11, lines 2-15; and Figure 4.

Claim 26 depends from independent claim 1 and specifies that the pair of extendable elongate shells are each capable of simultaneously holding different ice fishing tackle items. See page 9, lines 9-11; Figure 4; page 11, line 27, through page 12, line 13; and Figure 5.

Claim 27 depends from dependent claim 26 and specifies that the different ice fishing tackle items are (1) pre-rigged ice fishing rods, (2) pre-rigged ice-fishing tip-ups, or (3) a pre-rigged ice fishing rod and a pre-rigged ice-fishing tip-up. See Figure 3 (as amended in Amendment After Final filed on May 6, 2002) and page 10, lines 12-25 (as amended in Amendment After Final filed on May 6, 2002).

Claim 28 depends from independent claim 1 and specifies that each extendable elongate shell comprises an adjustable stop. According to claim 28, the adjustable stop is effective to hold one of the extendable elongate shells at a selected level of extension. See page 9, lines 18-27, and Figure 4.

Claim 29 depends from independent claim 1 and specifies that each extendable elongate shell has a proximal end and a distal end,. According to claim 29, the proximal end of each extendable elongate shell has a rounded surface that is adequate to minimize abrasion of any fishing line that rests against the proximal end of any extendable elongate shell. See page 4, line 27, through page 5, line 2; Figure 3 (as amended in Amendment After Final filed on May 6, 2002); page 11, lines 16-26; and Figure 4.

Claim 30 defines an ice fishing tackle storage apparatus. The apparatus of claim 30 comprises a pair of elongate shells, a first spacing component, and a second spacing component that

IX. Another issue is whether claims 40 and 42 are obvious under 35 U.S.C. §103 considering the over the McEwen patent, as applied to claims 19 and 23, and further in view of the Wolniak patent.

GROUPING OF CLAIMS

The following groupings of claims are made solely in the interest of consolidating issues and expediting this Appeal. No grouping of claims is intended to be, nor should be interpreted as being, any form of admission or a statement as to the scope or obviousness of any feature of any claim.

Claims 1-43 do not stand or fall together. Instead, claims 1-43 are divided into the following thirty-two groups. The claims of each individual group are to be separately considered in relation to particular rejections:

Group No. 1: claims 1, 6, 7, 9, 26, and 27.

Group No. 2: claim 2.

Group No. 3: claim 3.

Group No. 4: claim 4.

Group No. 5: claim 5.

Group No. 6: claim 8.

Group No. 7: claim 24.

Group No. 8: claim 25.

Group No. 9: claim 28.

Group No. 10: claim 29.

Group No. 11: claims 10-13 and 17-18.

Group No. 12: claim 14.

Group No. 13: claim 15.

Group No. 14: claim 16.

Group No. 15: claims 19 and 22.

Group No. 16: claim 20.

Group No. 17: claim 21.
Group No. 18: claim 39.
Group No. 19: claim 40.
Group No. 20: claim 23.
Group No. 21: claim 41.
Group No. 22: claim 42.
Group No. 23: claim 30.
Group No. 24: claim 31.
Group No. 25: claim 32.
Group No. 26: claim 33.
Group No. 27: claim 34.
Group No. 28: claim 35.
Group No. 29: claim 36.
Group No. 30: claim 37.
Group No. 31: claim 38.
Group No. 32: claim 43.

ARGUMENT

I. The Thibodeaux Patent Does Not Anticipate Claims 1-2, 7-9, and 24-26.

A. The Examiner failed to establish that the Thibodeaux patent discloses each and every element of claims 1, 2, 3, 4, 5 8, 24, 25, 28, and 29.

The Examiner has alleged the Thibodeaux patent anticipates claims 1-2, 8, 24, and 25 under 35 U.S.C. §102(e). However, despite the Examiner's statements in support thereof, the Thibodeaux patent does not in fact anticipate any of claims 1-2, 8, 24, and 25 under 35 U.S.C. §102(e).

"For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference." In re Bond, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Furthermore, the elements disclosed by the single reference "must be

arranged as in the claim under review." Bond, 15 U.S.P.Q.2d at 1567. Moreover, "[i]n deciding the issue of anticipation, the trier of fact must identify the elements of the claims . . . and identify corresponding elements disclosed in the allegedly anticipating reference." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). Thus, "it is incumbent upon the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 U.S.P.Q.2d 1461, 1462 (P.T.O. Bd. Pat. App. & Int'l 1990).

The Examiner's basis for alleging the Thibodeaux patent anticipates claim 1 hinges on a mischaracterization of details disclosed in the Thibodeaux patent and consequently fails to establish anticipation of claim 1 by the Thibodeaux patent. In support of this rejection, the Examiner stated:

The patent to Thibodeaux shows an ice fishing storage apparatus having a pair of extendable elongate shells 12, 13, 14 having an interior surface that defines an elongate cavity. The shells are located adjacent to each other. The top portion 5 of the container acts as a spacing structure and secures the extendable elongate shells in a predetermined relation to each other.

(Office Action dated 03/25/03, page 3, lines 1-4). The comments of the Examiner demonstrate the Examiner is characterizing the top portion 5 of the Thibodeaux fisherman's cooler as a spacing structure. (See Thibodeaux patent, col. 2, lines 11-16 and lines 35-37; and Fig. 1). Furthermore, the Examiner characterizes the elements 12, 13, and 14, collectively, as an extendable elongate shell "having an interior surface that defines an elongate cavity." (See Thibodeaux patent, col. 2, lines 37-43; and Fig. 4). The Examiner further surmises that the pair of alleged extendable elongate shells are "located adjacent to each other." (See Thibodeaux patent, Fig. 1). However, the Examiner's characterization of the Thibodeaux fisherman's cooler is erroneous in several respects.

Claim 1 of the above-identified application reads as follows:

1. *An ice fishing tackle storage apparatus, the apparatus comprising:*

a pair of extendable elongate shells, the extendable elongate shells having an interior surface that defines an elongate cavity, the pair of extendable elongate shells located adjacent to each other, and ice fishing tackle capable of being positioned within the elongate cavity of each extendable elongate shell; and

a spacing structure, the pair of extendable elongate shells each secured by the spacing structure, the spacing structure effective to maintain the pair of extendable elongate shells in predetermined relation to each other, proximate the spacing structure.

(Emphasis added). The Examiner's mischaracterization of details about the fisherman's cooler disclosed in the Thibodeaux patent are plainly evident following consideration of the actual details disclosed in the Thibodeaux patent. First, it is clear the elements 12, 13, and 14 do not amount to an elongate shell, as alleged by the Examiner. Instead, the elements 12 in the fishing rod holder 10 constitute "a plurality of concentric cup members 12 of varying diameter." (Thibodeaux patent, col. 2, line 38, and Fig. 4; emphasis added). Next, the element 13 is a "longitudinal U-shaped groove in each of the concentric cup members 12. (Thibodeaux patent, col. 2, lines 41-42, and Fig. 4). Finally, the element 14 is a U-shaped protrusion that appears on the outer surface of each concentric cup member 12. (Thibodeaux patent, col. 2, lines 42-43, and Fig. 4).

Continuing, the Examiner alleges the cup members 12 collectively have an interior surface "that defines an elongate cavity." This is an erroneous conclusion, since the concentric cup members 12 are in fact simply cups, where the bottom of each cup *prevents* "adjacent" cups from collectively defining an elongate cavity. (Thibodeaux patent, col. 2, line 38). The Examiner attempts to disregard this textual disclosure the members 12 as "cup members" by instead merely relying on Figure 4 of the Thibodeaux patent where the "cup" aspect of the members 12 is effectively hidden from view.

Essentially, the different cup members 12 each have a varying diameter so that cups with a smaller diameter may nest in cups having a smaller diameter. (See Thibodeaux patent, col.

2, lines 35-40). This allows fisherman to remove those cup members 12 having a diameter smaller than the diameter of the rod desired to be held in the fishing rod holder 10. (Id).

Thus, despite the Examiner's characterization, Figure 4 of the Thibodeaux patent does not actually disclose an extendable series of members that collectively define an extendable elongate cavity. Instead, the depiction of the cup members 12 with varying diameters in Figure 4 simply shows the relationship of the inner diameter to the outer diameter of adjacent cup members 12. Indeed, viewing the fishing rod holders 10 that are depicted in Figure 1 of the Thibodeaux patent and viewing the cup members 12 in Figure 4 of the Thibodeaux patent, it is clear the height (depth) of the cup members 12 decreases from the cup with the largest diameter to the cup with the smallest diameter (to accommodate the thickness of the cup bottoms of each cup member 12) such that the cup members 12, when nested, likely do not extend above each other.

Nonetheless, even in light of these detailed comments about the cup members 12 of the Thibodeaux fisherman's cooler that have been presented repeatedly to the Examiner in response to prior Office Actions in this application, the Examiner responded to those prior comments with the following allegation in the latest Office Action:

Applicant argues that elements 12, 13, 14 of Thibodeaux do not constitute an elongate shell, but clearly from viewing Fig. 4 that is exactly what they are. . . . A tube is defined as a hollow cylinder and by viewing Fig. 4 of Thibodeaux, that is exactly what is shown The plural members 12 shown nested together can be considered as a male and female elongate tubes. . . .

(Office Action dated 03/25/03, page 7, lines 8-9, 13-14, and 16-17). The Examiner may want Figure 4 to disclose details about the plurality of cup members collectively forming the "extendable elongate shells" required by claim 1, but the Thibodeaux patent, such as in Figure 4, does not in fact show an extendable elongate shell "having an interior surface that defines an elongate cavity," as claim 1 requires and as exhaustively explained to the Examiner in the past

The Examiner's characterization disregards the textual details that are provided in the Thibodeaux patent in favor of the Examiner's reliance only on the Figure 4 depiction that effectively hides the "cup" facet of the members 12 that the text of the Thibodeaux patent discloses. Again, the Thibodeaux patent itself defines the cup members 12 in terms of "cup" terminology. Merriam

Webster's Collegiate Dictionary defines a "cup" as "an open usu. bowl-shaped drinking vessel" and as "a drinking vessel and its contents." See Exhibit A, Page 283, 10th ed. (Merriam-Webster, Incorporated 1993). These definitions of "cup," as well as the available disclosure from the Thibodeaux patent, are entirely inconsistent and non-supportive of the Examiner's contention that the cups of the Thibodeaux patent can be considered to instead be tubes. The Examiner's allegations turn the definition of cup on its head. In effect, the Examiner attempts to supplement the Thibodeaux patent with additional details dispensing with the disclosed "cup" facet of the members 12. Since the members 12 include this "cup" facet, as the Thibodeaux patent clearly states, it is impossible for the nesting cup members 12 depicted in Figure 4 to constitute an extendable elongate shell "having an interior surface that defines an elongate cavity," as claim 1 requires.

Claim 1 also requires that the pair of extendable elongate shells be "located adjacent to each other." The Examiner alleges: "The shells are located adjacent to each other." (Office Action dated 03/25/03, page 3, lines 2-3). However, to reach this conclusion, the Examiner was forced to step back and look at the Thibodeaux fisherman's cooler from a distance:

Since the rod holders are at opposite ends of the tackle box they can be considered to be adjacent since the term is relative and the claim does not define precisely what is considered as 'adjacent'. In other words, the rod holders are adjacent compared to the other end of the boat.

(Office Action dated 03/25/03, page 7, lines 10-13). Claim 1 defines an ice fishing tackle storage apparatus and specifies that as incorporated in that apparatus, the pair of extendable elongate shells are "located adjacent to each other."

The present application clearly does not disclose that, relative to the ice fishing storage apparatus itself, the extendable elongate shells are situated on the apparatus at positions that are about as far apart from each other as possible. Instead, the present application discloses that the elongate shells, such as the tubes 30, are in fact closely spaced with each other in the apparatus 10 and the apparatus 110. (Page 4, lines 27-28, and Figs. 1, 3, 5, and 6). In the Thibodeaux fisherman's cooler, on the other hand, the different groups of cup members 12 are located on the corners of the cooler about as far apart as possible (See Thibodeaux patent, Figure 1), as the Examiner admits in

the comments recited immediately above. The Examiner's characterization of what is meant by the term "adjacent" is strained, at best, and unreasonable, at worst, and fails to properly consider the disclosure of the present application regarding spacing of the elongate shells that are defined in claim 1. Furthermore, Applicant notes that the Examiner does not reject claim 1 under the second paragraph of 35 U.S.C. §112 and therefore does not consider the "adjacent" terminology to be indefinite. The Examiner's characterization of what is meant by the term "adjacent" is erroneous since it twists the meaning of the term "adjacent" to a point that effectively renders it meaningless. The Thibodeaux patent, absent the Examiner's erroneous approach to defining "adjacent," does not disclose the "adjacent" that claim 1 requires.

The foregoing comments demonstrate the Thibodeaux patent does not in fact disclose either of the extendable elongate shells with the interior surface that defines an elongate cavity, as required by claim 1. Furthermore, despite the Examiner's allegation, the fishing rod holders 10 of the Thibodeaux device are not located adjacent to each other, as claim 1 requires. Therefore, it is clear the Thibodeaux patent does not disclose the pair of extendable elongate shells that are located adjacent to each other, as required by claim 1. Consequently, the Thibodeaux patent does not show each and every element of claim 1, as required by Bond, 15 U.S.P.Q.2d at 1567.

Next, claim 2, which depends from claim 1, reads as follows:

2. *The ice fishing tackle storage apparatus of claim 1 wherein the spacing structure comprises a first template, the first template comprising a plurality of interior surfaces, the interior surfaces defining a plurality of apertures that extend through the first template, each extendable elongate shell passing through one of the apertures of the first template.*

(Emphasis added). Claim 2 thus requires a first template, where interior surfaces of the first template define "a plurality of apertures that extend through the first template." Furthermore, claim 2 requires that each extendable elongate shell pass through one of the apertures of the first template."

The Thibodeaux patent describes a bore that receives the cup member 12 with the largest outside diameter. (Col. 2, lines 46-49). The bore is not depicted in any of the figures of the Thibodeaux patent. (See Thibodeaux patent, Figures 1-4). Thus, the Thibodeaux patent does not disclose anything about the bore extending through the top portion 5. Rather, all we know is that

the cup members 12 rest in this bore. (Col. 2, lines 46-49). Furthermore, neither the Thibodeaux patent nor the Examiner's comments about the Thibodeaux patent say anything about there being a friction fit between the largest diameter cup member 12 and the bore. Additionally, it is noted that the cup members 12 do not include any type of lip that would prevent the cup members 12, such as the largest diameter cup member 12, from slipping through the bore. (See Thibodeaux patent, Figure 4).

Consequently, it is clear the bore of the Thibodeaux fisherman's apparatus does not extend through the top surface 5, but instead *apparently* has a bottom surface that supports the cup members 12 and prevents the cup members 12 from falling through the bore. Again, just as the Thibodeaux patent does not disclose anything about the bore extending through the top portion 5, the Thibodeaux patent does not explicitly state anything about the bore having a bottom surface that supports the cup members 12 and prevents the cup members 12 from falling through the bore. However, this is a reasonable conclusion to reach based on the facts that are disclosed by the Thibodeaux patent.

The foregoing comments demonstrate the Thibodeaux fisherman's cooler does not include a "plurality of apertures that extend through the first template" as required by claim 2. Furthermore, it is clear the cup members 12 do not pass through the bore of the Thibodeaux fisherman cooler. Consequently, the Thibodeaux patent does not disclose the required detail of claim 2 about "each extendable elongate shell passing through one of the apertures of the first template." Consequently, the Thibodeaux patent does not show each and every element of claim 2, as required by Bond, 15 U.S.P.Q.2d at 1567.

Claim 8 of the above-identified application depends from claim 7, where claim depends from independent claim 1. Claim 8 reads as follows:

8. *The ice fishing tackle storage apparatus of claim 7 wherein the female elongate shell and the male elongate shell are each tubes.*

Claim 8 thus requires that at least one of the extendable elongate shells defined in claim 1 comprises a female elongate shell and a male elongate shell, as defined in claim 7. Claim 8 further requires that the female elongate shell and the male elongate shell each be tubes.

The Thibodeaux patent discloses cup members 12. As explained above, these cup members 12 do not constitute tubes, despite the Examiner's characterization to the contrary, since the members 12 instead are cup-shaped and therefore have bottoms, as explained above, and, as characterized in the Thibodeaux patent, are cups. Consequently, it is clear the Thibodeaux patent does not disclose the female elongate shell and the male elongate shell as tubes, in accordance with claim 8. Consequently, the Thibodeaux patent does not show each and every element of claim 8, as required by Bond, 15 U.S.P.Q.2d at 1567.

Claim 24 of the above-identified application, which depends from independent claim 1, reads as follows:

24. *The ice fishing tackle storage apparatus of claim 1 wherein the pair of extendable elongate shells comprise:*

a first extendable elongate shell having a first interior surface that defines a first elongate cavity, the first extendable elongate shell comprising a plurality of separable elongate shell components, each elongate shell component having an inner surface that defines an elongate cavity portion, the elongate cavity portions of each adjacent elongate shell component in communication with each other and the elongate cavity portions collectively forming the first elongate cavity; and

a second extendable elongate shell having a second interior surface that defines a second elongate cavity.

(Emphasis added). Thus, claim 24 requires, for the first extendable elongate shell, that the "elongate cavity portions of each adjacent elongate shell component [be] in communication with each other and the elongate cavity portions collectively forming the first elongate cavity." The Thibodeaux patent does not disclose this aspect of claim 24 for reasons analogous to those provided above with respect to claim 1 and claim 2. Specifically, the Thibodeaux patent discloses nested cup members 12, but does not disclose anything about these cups having elongate cavities that are in communication with each other.

The Examiner, however, continues to allege to the contrary:

Applicant argues that elements 12, 13, 14 of Thibodeaux do not constitute an elongate shell, but clearly from viewing Fig. 4 that is

exactly what they are. . . . A tube is defined as a hollow cylinder and by viewing Fig. 4 of Thibodeaux, that is exactly what is shown The plural members 12 shown nested together can be considered as a male and female elongate tubes. Also, in reference to claim 24, the elongate cavity portions of each adjacent shell component are in communication with each other. . . .

(Office Action dated 03/25/03, page 7, lines 8-9, 13-14, and 16-18, and page 8, line 1). The Examiner may want Figure 4 to disclose details about the plurality of cup members collectively forming “elongate cavity portions” that are “in communication with each other and the elongate cavity portions collectively forming the first elongate cavity,” as required by claim 1. Instead, consistent with the analogous reasons provided above with respect to claim 1 and claim 2, the Thibodeaux patent, such as in Figure 4, does not in fact show “male and female elongate tubes” that constitute elongate shell components, where “the elongate cavity portions of each adjacent shell component are in communication with each other,” as the Examiner alleges. Consequently, and as exhaustively explained to the Examiner in the past, the Thibodeaux patent does not disclose the “elongate cavity portions of each adjacent elongate shell component in communication with each other and the elongate cavity portions collectively forming the first elongate cavity” detail required by claim 24. Therefore, the Thibodeaux patent does not show each and every element of claim 24, as required by Bond, 15 U.S.P.Q.2d at 1567.

Next, claim 25 depends from independent claim 1 reads as follows:

25. *The ice fishing tackle storage apparatus of claim 1 wherein each elongate cavity is selectively and reversibly capable of being lengthened or shortened.*

The Thibodeaux patent does not disclose any ability to selectively lengthen or shorten the elongate cavity of either of the pair of extendable elongate shells of claim 1 in accordance with claim 25.

Applicant notes that the Examiner provides no statement about how the Thibodeaux patent allegedly discloses the details required by claim 25 and therefore provides no statement about why the Thibodeaux patent is allegedly anticipated by the Thibodeaux patent. Therefore, the Examiner’s rejection of claim 25 as allegedly being anticipated by the Thibodeaux patent is erroneous, since “the trier of fact must identify the elements of the claims . . . and identify

corresponding elements disclosed in the allegedly anticipating reference." Lindemann Maschinenfabrik GMBH, 221 U.S.P.Q. at 485. The Examiner has not born the burden of identifying "wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 U.S.P.Q.2d at 1462.

In connection with the Examiner's rejection of claims 27-29 under 35 U.S.C. §103(a) based upon the Thibodeaux patent that is discussed subsequently, the Examiner alleges the Thibodeaux patent "shows a stop 13-14" and that it would allegedly "have been obvious to employ an adjustable stop." However, as discussed above in regard to the Examiner's anticipation rejection based on the Thibodeaux patent, the element 13 is a longitudinal U-shaped groove, while the element 14 is a U-shaped protrusion. (Thibodeaux patent, col. 2, lines 35-49, and Fig. 4). These U-shaped grooves 13 and associated U-shaped protrusions 14 are not stops and are not characterized in the Thibodeaux patent as stops. Furthermore, the Thibodeaux patent does not characterize the element 13 and/or the element 14 as cooperating in a way that supports the Examiner's apparent allegation about the elements 13, 14 serving as a mechanism for allowing selective elongation of the non-existent communicative cavities of the different cup members 12. Rather, as mentioned in the Thibodeaux patent, the U-shaped grooves 13 and associated U-shaped protrusions 14 simply prevent "each cup member from rotating relative to the others." (Thibodeaux patent, col. 2, lines 41-46).

Consequently, and as exhaustively explained to the Examiner in the past, the Thibodeaux patent does not disclose the "wherein each elongate cavity is selectively and reversibly capable of being lengthened or shortened" detail required by claim 25. Therefore, the Thibodeaux patent does not show each and every element of claim 25, as required by Bond, 15 U.S.P.Q.2d at 1567.

The Thibodeaux patent does not disclose each and every detail required by any of claim 1, 2, 8, 24, or 25. Claims 1, 2, 8, 24, and 25 are therefore not anticipated by the Thibodeaux patent. Consequently, the Examiner erred in rejecting claims 1, 2, 8, 24, and 25 under U.S.C. §102(e) based upon the Thibodeaux patent. Reconsideration and reversal of the rejections of claims 1, 2, 8, 24, and 25 accompanied by allowance of claims 1, 2, 8, 24, and 25 are respectfully requested.

B. Claims 7, 9, and 26 are each allowable because they depend from an allowable claim.

The Examiner has alleged the Thibodeaux patent anticipates claims 7, 9, and 26 under 35 U.S.C. §102(e). Claims 7, 9, and 26 each depend from independent claim 1 and further define the ice fishing tackle storage apparatus. The Examiner provided no comments specifically relating to claims 7, 9, or 26. The Examiner has therefore not established that the inventions of claims 7, 9, or 26 are anticipated by the Thibodeaux patent, since the Examiner has failed to "identify the elements of the claims . . . and identify corresponding elements disclosed in the" Thibodeaux patent. Lindemann Maschinenfabrik GMBH, 221 U.S.P.Q. at 485. Furthermore, since claims 7, 9, and 26 each depend from independent claim 1, the Examiner has failed to establish that the inventions of claims 7, 9, and 26 are anticipated by the Thibodeaux patent, for the reasons stated above with respect to claim 1. Consequently, the Examiner erred in rejecting claims 7, 9, and 26 under U.S.C. §102 based upon the Thibodeaux patent. Reconsideration and reversal of the rejections of claims 7, 9, and 26 accompanied by allowance of claims 7, 9, and 26 are respectfully requested.

II. The Wolniak Patent Does Not Anticipate Claims 10-15, 17-18, 30-34, and 37-38 Under 35 U.S.C. §102(b).

A. The Wolniak patent does not disclose each and every element defined in claims 10, 14, 15, 30-34, and 37-38.

The Examiner has alleged the Wolniak patent anticipates claims 10, 14, 15, 30-34, and 37-38 under 35 U.S.C. §102(b). However, despite the Examiner's statements in support thereof, the Wolniak patent does not in fact anticipate any of claims 10, 14, 15, 30-34, 37, or 38-38 under 35 U.S.C. §102(b). In support of this rejection, the Examiner stated:

The patent to Wolniak shows an ice fishing and fishing storage device. In reference to claims 10, 30-34, Wolniak shows a pair of elongate shells 30, 30a, each having an interior surface that defines an elongate cavity that ice fishing tackle is capable of being positioned within. Wolniak shows a first spacing component or template 26 having a plurality of interior surfaces that define a plurality of apertures 22 and a second spacing component 21 in Fig. 2 Wolniak shows apertures or holes 23 in the bottom wall of the

container which also can be considered as sockets which are joined to the elongate shells.

(Office Action dated 03/25/03, page 3, lines 7-11 and lines 15-17).

Claim 10 of the above-identified application reads as follows:

10. (Amended) An ice fishing tackle storage apparatus, the apparatus comprising:

a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity, at least one of the elongate cavities having a length that is adequate to accept a portion of an ice fishing rod within the at least one elongate cavity, the ice fishing rod having a tip and a handle, a reel or a line windup attached to the ice fishing rod proximate the handle, the portion of the ice fishing rod extending from a tip of the ice fishing rod to the reel or line windup;

a first spacing component, the pair of elongate shells each secured by the first spacing component; and

a second spacing component, at least one of the elongate shells secured by the second spacing component, the second spacing component spaced apart from the first spacing component.

(Emphasis added). Claim 10 thus requires a pair of elongate shells that each define elongate cavities. Claim 10 further requires that at least one of the elongate cavities have a length adequate to accept a portion of an ice fishing rod, where the portion is defined as "extending from a tip of the ice fishing rod to the reel or line windup." Thus, at least one of the elongate cavities is required by claim 10 to be long enough to accept most of an ice fishing rod.

The Wolniak patent discloses a fishing tackle box with vertically disposed display tubes 30. (Col. 4, lines 11-14; Fig. 1; and Fig. 2). However, these tubes 30 fit within what is depicted as a conventional fishing tackle box with a top that closes over the tubes. The Wolniak patent is purely concerned with storage of artificial fishing lures in the individual tubes 30. (Col. 1, lines 7-17; col. 3, line 59 through col. 4, line 10; and Fig. 3). Indeed, the Wolniak patent further discloses that the cover portions 20a and 20b cover the upper ends of the tubes 30 to prevent the lures from falling out of the individual tubes 30 in the event the tackle box is overturned. (Col. 4,

lines 26-44; and Figure 1). There is clearly no disclosure in the Wolniak patent about the tubes 30 having a length that is capable of accepting the majority of an ice fishing rod, as claim 10 requires. Indeed, the covers 20a and 20b would not allow storage of an ice fishing rod in the tubes 30, since the reel or line windup parts of the rods and handle portions of the rod opposite the tip of the rod, which each may permissibly extend outside (or above) the elongate cavity of a particular elongate shell, would prevent the cover portions 20a and 20b from being closed.

Furthermore, as mentioned above, the tubes 30 are intended solely for storing fishing lures. There is no disclosure in the Wolniak patent about the tubes 30 having a length long enough to accommodate a portion of an ice fishing rod extending from the tip of the ice fishing rod to the reel or line windup, as required by claim 10. Thus, the Wolniak patent does not disclose each and every feature that is required by claim 10.

The Examiner attempted to dispense with the ice fishing rod acceptance capability detail of claim 10 using the following allegations:

As to Wolniak, applicant argues that the tubes 30 are not long enough to store the tip portion of an ice fishing rod extending to the tip or line windup. However, applicant has not defined this distance and the tubes of Wolniak show the structure to perform the function and are **certainly** long enough to store a short ice fishing rod. Applicant has submitted no evidence that Wolniak will not store part of a fishing rod.

(Office Action dated 03/25/03, page 8, lines 1-5; emphasis added).

Applicant knows of no evidence of record produced by the Examiner demonstrating that the Wolniak tubes “are certainly long enough to store a short ice fishing rod.” Indeed, there is no evidence of record establishing the existence of ice fishing rods as short as the fishing lures intended to be showcased in the tubes 30 of the Wolniak tackle box. There is clearly no disclosure in the Wolniak patent or evidence of record about the tubes 30 having a length that is capable of accepting the majority of an ice fishing rod, as claim 10 requires. The Wolniak box is disclosed as having a structure and size sufficient to hold fishing lures, not longer objects such as ice fishing rods.

The Wolniak patent does not disclose anything about the tubes 30 having a length long enough to accommodate a portion of an ice fishing rod extending from the tip of the ice fishing

rod to the reel or line windup, as required by claim 10. Thus, the Wolniak patent does not disclose each and every feature that is required by claim 10. Therefore, the Wolniak patent does not show each and every element of claim 10, as required by Bond, 15 U.S.P.Q.2d at 1567.

Claim 14 depends from independent claim 10 and reads as follows:

14. (Amended) The ice fishing tackle storage apparatus of claim 10 wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the wall comprising one or more interior surfaces that define a recess in the wall or an aperture through the wall, the second spacing component comprising the recess or the aperture, one of the elongate shells passing through the aperture of the wall or positioned in the recess of the wall.

Claim 14 thus requires a container with a wall, where the wall has interior surfaces that define a recess in the wall or an aperture through the wall. Claim 14 further specifies that one of the elongate shells previously defined in claim 10 passes “through the aperture of the wall” or is “positioned in the recess of the wall.”

The Examiner alleges that “Wolniak shows apertures or holes 23 in the bottom wall of the container which also can be considered as sockets that are joined to the elongate shells.” (Office Action dated 03/25/03, page 3, lines 15-17). The Examiner is correct that the Wolniak patent discloses holes 23 in the bottom wall of the container. However, the Examiner incorrectly characterizes the holes 23 “as sockets which are joined to the elongate shells.”

With regard to the holes 23, the Wolniak patent states:

The bottom panel 13 is formed with a plurality of holes 23 therethrough which are formed to be positioned within the interior of each one of a plurality of vertically disposed display tubes 30 so that water dripping through the lures can pass out from the tackle box and air can circulate through to dry the lure.

(Col. 3, lines 14-19). This is the only disclosure in the Wolniak patent about the holes 23, other than the depiction of the holes 23 in Figure 1. There is no disclosure whatsoever about any joining of the tubes 30 with the holes 23. Instead, the Wolniak patent merely discloses positioning of an open end of the tubes 30 over the holes 23 to allow drainage of the tubes 30. Clearly, there is no disclosure in the Wolniak patent about a recess in the bottom of the container, where the tubes are positioned

in the recess, as claim 14 requires. Likewise, there is no disclosure in the Wolniak patent about an aperture in the bottom of the container, where the tubes 30 pass *through* the aperture, as claim 14 requires. Indeed, as seen in Figure 1 of the Wolniak patent, it is clear the diameters of the holes 23 are much smaller than the diameters of the tubes 30.

Faced with these facts, the Examiner developed a supplemental characterization of the details disclosed in the Wolniak patent:

The holes of Wolniak can be considered to be frictionally joined to the tubes noting Fig. 2 which shows the tubes extending to the bottom wall of the tackle box which is where the holes are located. From Fig. 2, the tubes cover the holes and thus can be considered sockets. Also, panel 21 has an aperture which the tubes extend through and hence can be considered as a socket. Wolniak shows the panel 21 with apertures for the tubes to be in contact with the walls, such as end wall 12, or the container. Hence, Wolniak discloses every claimed feature in claims 14-15.

(Office Action dated 03/25/03, page 8, lines 5-12). Claim 14 specifies the ice fishing tackle storage apparatus is positioned in a container that has a wall and further requires that the container wall comprises “one or more interior surfaces that” the “recess in the wall or an aperture through the wall” where “one of the elongate shells” passes “through the aperture of the wall or positioned in the recess of the wall.” This latest argument of the Examiner recited immediately above illustrates the Examiner has abandoned the prior tactic of alleging the holes 23 of the Wolniak tackle box constitutes the container wall aperture required by claim 14. Now, the Examiner instead attempts to get around the container wall requirement of claim 14 by characterizing the flotation panel 21 as being one of the container walls. Clearly, this is a mischaracterization, since the Wolniak patent instead states that the flotation panels 21 are separate elements that may be secured to the bottom panel 13 (bottom wall) of the tackle box, if desired. (Wolniak patent; col. 3, lines 50-53; Fig. 1; and Fig. 2). However, the fact remains that these panels are flotation members that do not constitute a wall of the container, as claim 14 requires. Any conclusion to the contrary essentially does away with any distinction between a wall of a container and a separate layer that is placed in the container. Though the Wolniak patent discloses passage of the tubes 30 through apertures in the flotation

panels, the Wolniak patent simply does not disclose passage of the tubes 30 through apertures, such as the holes 23, of walls possessed by the Wolniak tackle box.

Undoubtedly, the Wolniak patent does not disclose the recess or the aperture in the container wall that are required in the alternative by claim 14 or the relationship of the elongate shell to either the container aperture or the container recess, as required in the alternative by claim 14. Consequently, it is clear the Wolniak patent does not disclose each and every feature required by claim 14. Therefore, the Wolniak patent does not show each and every element of claim 14, as required by Bond, 15 U.S.P.Q.2d at 1567.

Claim 15 also depends from independent claim 10 and reads as follows:

15. *The ice fishing tackle storage apparatus of claim 10 wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the apparatus further comprising a socket, the socket attached to the wall of the container, and one of the elongate shells positioned in the socket.*

The comments provided above with respect to the hole 23 of the Wolniak patent in the context of the recess or the aperture of claim 14 are equally applicable to the socket that is defined in claim 15.

Claim 15 requires a socket that is attached to the wall of the container, with one of the elongate shells being positioned in the socket. The Examiner's comments about the holes 23 being considered as sockets "which are joined to the elongate shells," is a stretch to the imagination that is not disclosed by the Wolniak patent. Indeed, the tubes 30 would not even come near being able to fit within these alleged "sockets" (holes 23) that are disclosed as drainage holes with a smaller diameter than the diameter of the tubes 30. Clearly, the Wolniak patent does not disclose the socket or positioning of the elongate shell in the socket as required by claim 15. Therefore, the Wolniak patent does not show each and every element of claim 15, as required by Bond, 15 U.S.P.Q.2d at 1567, and consequently does not anticipate claim 15.

Next, claim 30 of the above-identified application reads as follows:

30. *An ice fishing rod storage apparatus, the apparatus comprising: a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing rods capable of being individually*

*positioned within the elongate cavities of the different elongate shells;
a first spacing component, the pair of elongate shells each secured by the first spacing component; and
a second spacing component, at least one of the elongate shells secured by the second spacing component, the second spacing component spaced apart from the first spacing component.*

For reasons analogous to those provided above with regard to claim 10, the Wolniak patent does not in fact disclose anything about ice fishing rods being individually positionable within the tubes 30 of the Wolniak fishing tackle box, despite the Examiner's comments to the contrary. Indeed, as previously noted, the covers 20a and 20b would not allow storage of an ice fishing rod in the tubes 30, since the reel or line windup parts of the rods and handle portions of the rods opposite the tip of the rods would prevent the cover portions 20a and 20b of the Wolniak fishing tackle box from being closed. Therefore, the Wolniak patent does not show each and every element of claim 30, as required by Bond, 15 U.S.P.Q.2d at 1567, and consequently does not anticipate claim 30.

Next, claim 31 that depends from independent claim 30 reads as follows:

31. *The ice fishing rod storage apparatus of claim 30 wherein the ice fishing rods are capable of being individually positioned within the elongate cavities of the different elongate shells with tips of the rods within the elongate cavities and with either the reels or line windups of the ice fishing rods or fishing line extending from the reels or line windups in contact with the elongate shells.*

For reasons analogous to those provided above with regard to claim 10, the Wolniak patent does not disclose the details required by claim 31 regarding the ability to position ice fishing rods in the tubes 30 in the manner defined in claim 31. Therefore, the Wolniak patent does not show each and every element of claim 31, as required by Bond, 15 U.S.P.Q.2d at 1567, and consequently does not anticipate claim 31.

Next, claims 32 and 33 read as follows:

32. *An ice fishing tackle storage apparatus, the apparatus comprising:
a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and*

*ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell;
a first spacing component, the pair of elongate shells each secured by the first spacing component; and
a second spacing component, at least one of the elongate shells secured by the second spacing component, the second spacing component spaced apart from the first spacing component;
wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the wall comprising a one or more interior surfaces that define a recess in the wall or an aperture through the wall, the second spacing component comprising the recess or the aperture, one of the elongate shells passing through the aperture of the wall or positioned in the recess of the wall.*

33. *An ice fishing tackle storage apparatus, the apparatus comprising:
a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell;
a first spacing component, the pair of elongate shells each secured by the first spacing component; and
a second spacing component, at least one of the elongate shells secured by the second spacing component, the second spacing component spaced apart from the first spacing component;
wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the apparatus further comprising a socket, the socket attached to the wall of the container, and one of the elongate shells positioned in the socket.*

For reasons analogous to those provided above with regard to claim 14, the Wolniak patent does not disclose the recess in the wall or the aperture through the wall that are required in the alternative by claim 32. Likewise, for reasons analogous to those provided above with regard to claim 15, the Wolniak patent does not disclose the socket details that are required by claim 33. Therefore, the

Wolniak patent does not show each and every element of either claim 32 or claim 33, as required by Bond, 15 U.S.P.Q.2d at 1567, and consequently does not anticipate either claim 32 or claim 33.

Next, claim 34 reads as follows:

34. *An ice fishing tackle storage system, the ice fishing tackle storage system comprising an ice fishing storage apparatus, the apparatus comprising:*

- a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell; and*
- a first spacing component, the pair of elongate shells each secured by the first spacing component; and*
- a first wall, the first wall attached to the first spacing component; and*
- a container, the ice fishing tackle storage apparatus positioned in the container, the container having a second wall, the first wall and the second wall defining a chamber within the container, an ice fishing tip-up capable of being placed in the chamber.*

Thus, claim 34 requires that the ice fishing tackle storage system be positioned in a container, where the ice fishing tackle storage system comprises a first wall that is attached to the first spacing component and the container has a second wall, with the first and second walls defining a chamber within the container and an ice fishing tip-up capable of being placed in the chamber thereby defined.

Wolniak patent does not disclose any such chamber or walls defining such a chamber. Instead, the tubes 30 and associated spacing components of the Wolniak tackle box prevent any such chamber from existing. Thereby, the Wolniak tackle box lacks any ability to position a tip-up within such a chamber, as required by claim 34. Therefore, the Wolniak patent does not show each and every element of claim 34, as required by Bond, 15 U.S.P.Q.2d at 1567, and consequently does not anticipate claim 34.

Next, claim 37 reads as follows:

37. *An ice fishing tackle storage apparatus, the apparatus comprising:*
a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell; the elongate shells each having both a distal end and a proximal end;
a first spacing component, the pair of elongate shells each secured by the first spacing component, the first spacing component having a distal surface and a proximal surface; and
a second spacing component, at least one of the elongate shells secured by the second spacing component, the second spacing component spaced apart from the first spacing component;
wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a closed bottom end and an open upper end, the first spacing component positioned at the open upper end.

Thus, claim 37 defines an ice fishing tackle storage apparatus, where the ice fishing tackle storage apparatus is “positioned in a container.” Claim 37 further requires that the container have a closed bottom end. The Wolniak patent does not disclose such a container with a closed bottom end, since the Wolniak patent instead discloses holes 23 through the bottom of the Wolniak fishing tackle box. (Wolniak patent, col. 3, lines 14-19; Fig. 1; and Fig. 2). Therefore, the Wolniak patent does not show each and every element of claim 37, as required by Bond, 15 U.S.P.Q.2d at 1567, and consequently does not anticipate claim 37.

Finally, claim 38 of the above-identified application that depends from claim 37 reads as follows:

38. *The ice fishing tackle storage apparatus of claim 37, wherein the proximal end of at least one of the elongate shells is flush with the proximal surface of the first spacing component.*

Claim 38 thus requires that the proximal end of at least one of the elongate shells be flush with the proximal surface of the first spacing component. The Wolniak patent does not disclose this feature

that is required by claim 38 since the Wolniak patent discloses that each and every one of the proximal end of the tubes 30 extend well above the uppermost spacing component of the Wolniak tackle box. (Wolniak patent, Fig. 2). Therefore, the Wolniak patent does not show each and every element of claim 38, as required by Bond, 15 U.S.P.Q.2d at 1567, and consequently does not anticipate claim 38.

B. Claims 11-13 and 17-18 are each allowable because they depend from an allowable claim.

The Examiner has alleged the Wolniak patent anticipates claims 11-13 and 17-18 under 35 U.S.C. §102(b). Claims 11-13 and 17-18 each depend from independent claim 10 and further define the ice fishing tackle storage apparatus. Since claims 11-13 and 17-18 each depend from independent claim 10, the Examiner has failed to establish that the inventions of claims 11-13 and 17-18 are anticipated by the Wolniak patent, for the reasons stated above with respect to claim 10. Consequently, the Examiner erred in rejecting claims 11-13 and 17-18 under U.S.C. §102(b) based upon the Wolniak patent. Reconsideration and reversal of the rejections of claims 11-13 and 17-18 accompanied by allowance of claims 11-13 and 17-18 are respectfully requested..

III. The McEwen Patent Does Not Anticipate Claims 19, 21-23, 39, Or 41.

A. The McEwen patent does not disclose each and every element defined in claims 19, 21, 23, 39, or 41.

The Examiner has alleged the McEwen patent anticipates claims 19, 21, 23, 39, and 41 under 35 U.S.C. §102(b). However, despite the Examiner's statements in support thereof, the McEwen patent does not in fact anticipate any of claims 19, 21, 23, 39, and 41 under 35 U.S.C. §102(b). In support of this rejection, the Examiner alleged:

The patent to McEwen shows an ice fishing tackle storage apparatus having a plurality of elongate shells 16 having an elongate interior cavity, a spacing structure 20, 20 secured to the shells and a plurality of legs 40, 42 attached to the shells. McEwen shows a container 10. McEwen shows the elongate shells capable of securing ice fishing

tackle therein. The spacing structure 20, 20 is effective to maintain two or more of the elongate shells in predetermined relation with each other proximate the spacing structure. The elongate shells are capable of serving as legs that will stably support the apparatus on a surface when the two elongate shells are positioned in contact with the surface as shown in Fig. 8.

(Office Action dated 03/25/03, page 4, lines 1-8). Despite the Examiner's comments, the McEwen patent does not disclose each and every feature required by claims 19, 21-23, 39, and 41. Consequently, the McEwen patent does not anticipate any of claims 19, 21-23, 39, or 41.

Claim 19 of the above-identified application reads as follows:

19. *An ice fishing tackle storage apparatus, the apparatus comprising:*

a plurality of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity, and ice fishing tackle capable of being positioned within the elongate cavities of the elongate shells;

a spacing structure, the elongate shells secured by the spacing structure, the spacing structure effective to maintain two or more of the elongate shells in predetermined relation to each other, proximate the spacing structure; and

wherein at least two of the elongate shells are capable of serving as legs that will stably support the apparatus on a surface when the at least two elongate shells are positioned in contact with the surface, the spacing structure effective to prevent slippage of the at least two elongate shells with respect to the spacing structure.

Claim 19 thus requires a plurality of elongate shells that each have interior surfaces defining elongate cavities. Ice fishing tackle is capable of being positioned within the elongate cavities. A spacing structure is provided to secure two or more of the elongate shells in predetermined relation to each other, proximate the spacing structure. According to claim 19, "at least two of the elongate shells are capable of serving as legs that will stably support **the apparatus** on a surface when the at least two elongate shells are positioned in contact with the surface." (Emphasis added). Thus, at least two

of the elongate shells are capable of serving as legs that will stably support the apparatus that includes the plurality of shells and the spacing structure.

With regard to the McEwen patent, the Examiner relies upon Figure 8 as allegedly disclosing elongate shells that “are capable of serving as legs that will stably support the apparatus on a surface when the two elongate shells are positioned in contact with the surface as shown in Fig. 8.” While Figure 8 does show that a minor portion of the periphery of one end of one of the tubes 16 is in contact with the ground, this mere disclosure of the contact between this minor portion of the tube 16 with the ground does not establish anything about the ability of the tube 16, in the combination disclosed in Figure 8, to stably support the entire apparatus that includes the McEwen apparatus (i.e.: the container 10, the legs 40, 42, the tube 16, among other components).

Indeed, in relation to the disclosure in Figure 8, the McEwen patent discloses that the tubes 16, 18 by virtue of the minor contact of the tubes 16, 18 with the ground, are **not** responsible for the stability of the McEwen apparatus. Instead, the McEwen patent discloses that the bucket 10 is filled with water. (McEwen Patent, col. 4, lines 26-27). The McEwen patent discloses that this filling of the bucket with water is responsible for steadyng the apparatus, including the tubes 16 and 18. (McEwen patent, col. 4, lines 42-44, and Figure 8). The McEwen patent discloses nothing whatsoever about the tubes 16, 18 supporting the overall apparatus. Indeed, the legs 40, 42 are explicitly added for purposes of supporting the tubes 16, 18. (McEwen patent, col. 4, lines 42-44, and Figure 8). This further demonstrates the tubes 16, 18 do not support the overall apparatus of the McEwen patent, such as that disclosed in Figure 8. Mere contact of a minor portion of the tubes 16, 18 with the ground does not necessarily demonstrate support of the apparatus by the tubes 16, 18.

Nonetheless, despite the explicit disclosure in the McEwen patent that the filling of the bucket of water is responsible for steadyng the apparatus, including the tubes 16 and 18, and the foregoing comments of the prior three paragraphs that were submitted in response to prior Office Actions, the Examiner, in a prior Office Action, continued to make the groundless allegation that the minor portion of the tube 16 from Fig. 8 will stably support the overall apparatus:

As to McEwen as shown in Fig. 8, the tube 16 has part of the bottom portion in contact with the ground and can hence are capable of

serving as legs that will stably support the apparatus on a surface when the two elongate shells are positioned in contact with the surface.

(Office Action dated 11/06/01, last line on page 8 through first two lines on page 9). Once again, this is merely a groundless allegation by the Examiner that is not supported in fact by the McEwen patent. Instead, the McEwen patent, among other things, discloses that filling of the bucket of water is responsible for steadyng the apparatus, including the tubes 16 and 18. (McEwen patent, col. 4, lines 42-44, and Fig. 8). There is nothing whatsoever in the McEwen patent that would support the Examiner's allegation that the minor contact between the tubes 16, 18 and the ground surface would allow the tubes 16, 18 to stably support the overall McEwen apparatus. This is merely an allegation of the Examiner without any basis in fact.

Applicant also notes the Examiner characterizes the spacing structure of the McEwen patent as sleeves 20, 20. (Office Action dated 03/25/03, page 4, lines 4-6). However, the spacing structure of the McEwen device instead includes every component shown in the figures, other than the tubes 16, 18. (McEwen patent, col. 2, line 34, through col. 4, line 45; and Figs. 1-8). Absent these other components, including the handle 12, the nut and bolt arrangement 38, the bucket 10, the sleeve 30, 32, the elastic cords 34, 36, the sleeves 20, 22, the leg 40, 42, etc., the tubes would not be maintained in predetermined relation to each other and would not be prevented from slipping with respect to the spacing structure. All of the components beyond the tubes 16, 18 constitute the spacing structure, albeit a fairly complicated spacing structure, of the McEwen patent.

Thus, the legs 40, 42 in combination with the water placed in the bucket 10, are vitally necessary for support of the apparatus disclosed in the McEwen patent. (McEwen patent, col. 2, line 55, through col. 3, line 5). Clearly, mere contact between a small part of the tube 16, 18 with the ground plays only a minor role and is insufficient to stably support the overall apparatus. Even absent this disclosed contact of the tubes 16, 18, the water in the bucket would clearly support the overall apparatus in stable fashion. Furthermore, absent the contact between the tube 16, 18 and the ground, the remaining components of the apparatus in the McEwen patent, including the nut and bolt mechanism 38, would still constitute the support mechanism of the McEwen apparatus and would

still maintain the tubes 16, 18 in stable fashion to support a fishing rod inserted within the tube 16, 18.

As explained above, the McEwen patent does not disclose anything the tubes 16, 18 being capable of supporting the McEwen apparatus in stable fashion. Consequently, the McEwen patent does not disclose anything about at least two elongate shells that "are capable of serving as legs that will stably support the apparatus on a surface when the at least two elongate shells are positioned in contact with the surface," as claim 19 requires. Therefore, the McEwen patent does not show each and every element of claim 19, as required by Bond, 15 U.S.P.Q.2d at 1567, and consequently does not anticipate claim 19.

Claim 21 of the above-identified application depends from claim 19 and reads as follows:

21. The ice fishing tackle storage apparatus of claim 19 wherein the elongate shells each have a longitudinal axis, a length of at least one of the elongate shells selectively and reversibly adjustable along the longitudinal axis of the at least one elongate shell.

Claim 21 thus requires that a length of at least one of the elongate shells originally defined in claim 19 be selectively and reversibly adjustable along the longitudinal axis of the at least one elongate shell. The McEwen patent does not disclose any ability to extend the length of either the tube 16 or the tube 18. The Examiner implicitly recognizes this, since the Examiner does not point to any aspect in the McEwen patent covering any such length adjustment ability. Thus, the McEwen patent does not show each and every element of claim 21, as required by Bond, 15 U.S.P.Q.2d at 1567, and consequently does not anticipate claim 21.

Claim 23 of the above-identified application reads as follows:

23. An ice fishing tackle storage apparatus, the apparatus comprising:
a plurality of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity, and ice fishing tackle capable of being positioned within the elongate cavities of the elongate shells;
a spacing structure, the elongate shells secured by the spacing structure, the spacing structure effective to

maintain at least two of the elongate shells in predetermined relation to each other, proximate the spacing structure; and
a plurality of legs that are capable of supporting the apparatus on a surface when the legs are positioned in contact with the surface, the plurality of legs attached to the spacing structure or to any of the elongate shells.

Claim 23 thus requires a plurality of legs that are capable of supporting the apparatus on a surface when the legs are positioned in contact with the surface, where the apparatus that is capable of being supported comprises the elongate shells and the spacing structure.

As indicated above in connection the discussion of the Examiner's rejection of claim 19 based on the McEwen patent, there is no disclosure in the McEwen apparatus about the legs 40, 42 or the tubes 16, 18 having the capability of supporting the overall apparatus (tubes and spacing structure) of the McEwen apparatus. Instead, as exemplified by the need to fill the bucket 10 with water, it is clear the bucket, as opposed to the legs 40, 42 or the tubes 20, supports the overall apparatus that includes the bucket 10. Absent the water in the bucket 10, the McEwen patent clearly indicates that insufficient stability would exist, even with the use of the legs 40, 42. Therefore, the McEwen patent does not show each and every element of claim 23, as required by Bond, 15 U.S.P.Q.2d at 1567, and consequently does not anticipate claim 23.

Claim 39 of the above-identified application reads as follows:

39. *The ice fishing tackle storage apparatus of claim 19 wherein the spacing structure is free of contact with the surface.*

Claim 39, in turn, depends from claim 19 that reads as follows:

19. *An ice fishing tackle storage apparatus, the apparatus comprising:*

a plurality of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity, and ice fishing tackle capable of being positioned within the elongate cavities of the elongate shells;
a spacing structure, the elongate shells secured by the spacing structure, the spacing structure effective to maintain two or more of the elongate shells in

*predetermined relation to each other, proximate the spacing structure; and
wherein at least two of the elongate shells are capable of serving as legs that will stably support the apparatus on a surface when the at least two elongate shells are positioned in contact with the surface, the spacing structure effective to prevent slippage of the at least two elongate shells with respect to the spacing structure.*

As explained above in connection with the argument regarding the Examiner's rejection of claim 19 based upon the McEwen patent, the legs 40, 42 of the McEwen device constitute part of the spacing structure of the McEwen patent. Clearly, from Fig. 2 and Fig. 8 of the McEwen patent, the legs 40, 42, and thereby the spacing structure of the McEwen device, is in contact with the surface. Therefore, the McEwen patent does not show each and every element of claim 39, as required by Bond, 15 U.S.P.Q.2d at 1567, and consequently does not anticipate claim 39. Similar comments apply with regard to claim 41 that similarly specifies: "the spacing structure is free of contact with the surface." Therefore, the McEwen patent does not show each and every element of claim 41, as required by Bond, 15 U.S.P.Q.2d at 1567, and consequently does not anticipate claim 41.

B. Claim 22 is allowable because claim 22 depends from an allowable claim.

The Examiner has alleged the McEwen patent anticipates claim 22 under 35 U.S.C. §102(b). Claim 22 depends from independent claim 19 and further defines the ice fishing tackle storage apparatus. Since claim 22 depends from independent claim 19, the Examiner has failed to establish that the invention of claim 22 is anticipated by the McEwen patent, for the reasons stated above with respect to claim 19. Consequently, the Examiner erred in rejecting claim 22 under U.S.C. §102(b) based upon the McEwen patent. Reconsideration and reversal of the rejection of claim 22 accompanied by allowance of claim 22 is respectfully requested.

IV. The Thibodeaux Patent and the Morin Patent Do Not Teach, Suggest, or Make Obvious the Invention of the Present Application as Defined in Claim 3.

A. Claim 3 is allowable because claim 3 depends from an allowable claim.

The Examiner has alleged the Thibodeaux patent as applied to claim 1, in view of the Morin patent, renders claim 3 unpatentable under 35 U.S.C. §103. Claim 3 depends from independent claim 1 and further defines the ice fishing tackle storage apparatus. Since claim 3 depends from independent claim 1, the Examiner has failed to establish that the present invention, as defined in claim 3, is unpatentable over the Thibodeaux patent as applied to claim 1, in view of the Morin patent. Consequently, the Examiner erred in rejecting claim 3 under U.S.C. §103 based upon the Thibodeaux patent as applied to claim 1, in view of the Morin patent. Reconsideration and reversal of the rejection of claim 3 accompanied by allowance of claim 3 is respectfully requested.

B. The Examiner failed to establish that the Thibodeaux patent, in view of the Morin patent, renders claim 3 *prima facie* obvious under 35 U.S.C. §103 and further failed to establish motivation for making the proposed combination.

The Examiner has alleged the Thibodeaux patent as applied to claim 1, in view of the Morin patent, renders claim 3 unpatentable under 35 U.S.C. §103. In support of this rejection, the Examiner stated:

The patent to Thibodeaux shows an ice fishing tackle storage device as discussed above and show one template which is the top surface. Morin shows an ice fishing tackle storage apparatus having a first 14 and second 24 template to hold rod 12. In reference to claim 3, it would have been obvious to employ a second template in Thibodeaux as shown by Morin for the purpose of supporting the fishing rod in two places.

(Office Action dated 03/25/03, last three lines on page 4 through first two lines on page 5). Despite the Examiner's comments, the Thibodeaux patent and the Morin patent, either separately or in any combination, do not teach, suggest, disclose, or make obvious the invention of the above-identified application, as defined in claim 3.

Under 35 U.S.C. §103, the Examiner bears the burden of establishing a *prima facie* case of obviousness. In re Rijckaert, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show that the teachings from the prior art would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. Rijckaert, 28 U.S.P.Q.2d at 1956. To establish *prima facie* obviousness, the Examiner must show that the prior art **compels** the conclusion the Examiner seeks, and not merely that the prior art would reasonably allow the conclusion the Examiner seeks. In re Spada, 15 U.S.P.Q.2d 1655, 1657, n. 3 (Fed. Cir. 1990). "If the Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned." Rijckaert, 28 U.S.P.Q.2d at 1956.

Furthermore, some teaching, suggestion, or motivation must exist to modify a prior art reference in the fashion suggested or detailed by an Examiner. The mere fact that a reference could be modified to produce the claimed invention does not make the claimed invention obvious. Libbey-Owens Ford Co. v. BOC Group Inc., 4 U.S.P.Q.2d 1097, 1103 (D.N.J. 1987). Furthermore, the mere fact that the prior art discloses the components of a claimed invention does not make the invention obvious. Northern Telecom, Inc. v. Datapoint Corp., 15 U.S.P.Q.2d 1321, 1323 (Fed. Cir. 1990). Instead, "[s]omething in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination." Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988).

Finally, hindsight reconstruction of a claimed invention using the claimed invention as a model for picking and choosing details to use in modifying a prior art disclosure is improper. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). An Examiner should forget the invention at issue when considering whether it would be obvious to modify a prior art disclosure. See W.L. Gore & Assoc., Inc. v. Garlock, Inc., 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983).

Claim 3 depends from claim 2, which in turn depends from claim 1. Claim 3 reads as follows:

3. (Amended) *The ice fishing tackle storage apparatus of claim 2 wherein the spacing structure further comprises a second template, the second template comprising one or more interior surfaces, the one or more interior surfaces defining at least one aperture that*

extends through the second template, one of the extendable elongate shells passing through the aperture of the second template.

Claim 3 thus further defines the spacing structure of claim 2 in terms of a second template in addition to the first template that is defined in claim 2. Claim 3 requires that one of the extendable elongate shells pass through the aperture of the second template.

The Examiner characterizes the top portion 5 of the Thibodeaux fisherman's cooler as a first template. The Morin patent discloses a lower horizontal member 24 with a plurality of openings 25 and an upper horizontal member 14 with a plurality of openings 15, where the openings 15 and 25 are relatively vertically aligned with one another. (Morin patent, col. 2, line 62, through col. 3, line 4). The Examiner seeks to add another template in addition to the upper portion 5 for purposes of supporting the cup members 12. However, there is no teaching or suggestion from the Thibodeaux patent or the Morin patent about any need or motivation to so modify the Thibodeaux fisherman's cooler. Indeed, as explained above, the nested cup members 12 of varying diameter rest fully within the bore of the fishing rod holder 10 in the upper portion 5. (See discussion above in relation to the Examiner's rejection of claim 1 based upon the Thibodeaux patent under 35 U.S.C. §102). This negates any need for an additional support template, since each nest of cup members 12 is already fully supported by individual bores in the upper portion 5. Thus suggestion or motivation to make the Examiner's suggested modification is lacking and the alleged obviousness of making such a combination is lacking under the present facts. Uniroyal, Inc., 5 U.S.P.Q.2d at 1438.

As an additional comment, the bore of the Thibodeaux patent, as explained above in relation to the Examiner's §102 rejection, is not disclosed as extending fully through the upper portion 5. Instead, the bore 5 is apparently closed ended and possesses a bottom that supports the cup member 12 with the largest diameter, which in turn supports the top with the next smaller diameter, etc., etc. This characterization of the bore as being a closed end bore that does not extend fully through the upper portion 5 is clearly appropriate, since having bores that extended fully through the upper portion 5 would hinder the ability of the cooler to keep things held within the cooler cool. Therefore, adding the one of the templates 14, 24 with the holes 15, 25 extending

therethrough as a “second template” to work in combination with the upper portion 5 of the Thibodeaux fisherman’s cooler would first require an additional reconstruction by allowing the bores to extend fully through the upper portion 5.

There is not suggestion or motivation for such a reconstruction, since such a reconstruction would effectively open up the interior of the fisherman’s cooler to atmosphere and prevent the closed end bore from serving its important and intended function of helping keep goods within the cooler cool. This demonstrates that the Examiner has failed to establish *prima facie* obviousness, since the Examiner has not shown that the prior art **compels** the modification the Examiner proposed. In re Spada, 15 U.S.P.Q.2d at 1657, n. 3. Here, the art actually teaches away, rather than toward, the Examiner’s proposed modification, even if the Examiner’s proposed modification could in fact be accommodated.

Furthermore, even if the fisherman’s cooler of the Thibodeaux patent were somehow reconstructed to position the “second template” of the Morin patent within the fisherman’s cooler of the Thibodeaux patent and beneath the upper portion 5 (first template, in the words of the Examiner) of the Thibodeaux patent, the reconstructed fisherman’s cooler would still not equal the invention of the above-identified application, as defined in claim 3. The reconstructed fisherman’s cooler would not equal the invention of the above-identified application, as defined in claim 3, since the reconstructed cooler would continue to include the cup members 12 (each with a bottom, as explained above) in the bores of the upper portion 5 of the Thibodeaux patent. As explained above, the bores of the upper portion 12 are not disclosed as extending through the upper portion 5. Thus, the bores of the Thibodeaux patent in fisherman’s cooler reconstructed in accordance with the Examiner’s suggestion would prevent any extendable elongate shells (also lacking from the fisherman’s cooler reconstructed in accordance with the Examiner’s suggestion) from passing through the aperture of the second template transferred, per the Examiner’s suggestion, into the fisherman’s cooler.

Thus, there is clearly no motivation, suggestion, or teaching, as required by In re Fine, for substituting any of the templates 14, 24 with the through-bores 15, 25 in place of the upper portion 5 of the Thibodeaux fisherman’s cooler with the closed-end bores or as a supplement to the

upper portion 5 of the Thibodeaux fisherman's cooler with the closed-end bores. 5 U.S.P.Q.2d 1596. Consequently, it is clear the alleged combination of the Examiner based upon the Thibodeaux patent and the Morin patent does not teach, suggest, disclose, or render obvious the invention of the above-identified application, as defined in claim 3.

The Thibodeaux patent, in combination with the Morin patent, does not teach suggest, disclose, or render obvious the invention of the above-identified application, as defined in claim 3. Consequently, the Examiner erred in rejecting claim 3 under U.S.C. §103 based upon the Thibodeaux patent as applied to claim 1, in view of the Morin patent. Reconsideration and reversal of the rejection of claim 3 accompanied by allowance of claim 3 is respectfully requested.

V. The Thibodeaux Patent Does Not Render Claims 27-29 Obvious Under 35 U.S.C. §103.

A. Claims 27-29 are allowable because claims 27-29 each depend from an allowable claim.

The Examiner has alleged the Thibodeaux patent renders claims 27-29 unpatentable under 35 U.S.C. §103. Claims 27-29 each depend from independent claim 1 and further defines the ice fishing tackle storage apparatus. Since claims 27-29 each depend from independent claim 1, the Examiner has failed to establish that the present invention, as defined in claims 27-29, is unpatentable over the Thibodeaux patent. Consequently, the Examiner erred in rejecting claims 27-29 under U.S.C. §103 based upon the Thibodeaux patent. Reconsideration and reversal of the rejection of claims 27-29 accompanied by allowance of claims 27-29 is respectfully requested.

B. The Examiner failed to establish that the Thibodeaux patent renders claims 28-29 *prima facie* obvious under 35 U.S.C. §103 and motivation is lacking for modifying the Thibodeaux patent to attain the details of claims 28-29.

The Examiner has alleged the Thibodeaux patent renders claims 28-29 unpatentable under 35 U.S.C. §103. In support of this rejection, the Examiner stated:

The patent to Thibodeaux shows a fishing storage apparatus as discussed above. Thibodeaux shows holding fishing rods, but it

would have been obvious to hold other related fishing tackle such as tip-ups or ice fishing both pre-rigged or un-rigged since the function is the same. In reference to claim 28, Thibodeaux shows a stop 13-14. It would have been obvious to employ an adjustable stop. See *In re Stevens*, 101 USPQ 284. In reference to claim 29, Thibodeaux does not show a rounded surface at the proximal end of the elongate shell. However, it would have been obvious to a [sic] employ a rounded surface for the purpose for easier insertion of the fishing tackle. The examiner takes Official Notice that rounded surfaces are old and well known in fishing tackle storage devices.

(Office Action dated 03/25/03, page 5, lines 3-12). However, despite the Examiner's statements in support thereof, the Thibodeaux patent does not teach, suggest, disclose, or make obvious the invention of the above-identified application, as defined in claims 28-29.

Claim 28 of the above-identified application reads as follows:

28. *The ice fishing tackle storage apparatus of claim 1 wherein each extendable elongate shell comprises an adjustable stop, the adjustable stops effective to hold each extendable elongate shell at a selected level of extension.*

Claim 28 thus requires adjustable stops for each extendable elongate shell. As previously explained in connection with the Examiner's rejection of claim 1 under 35 U.S.C. §102 based upon the Thibodeaux patent, the Thibodeaux patent does not disclose any such extendable elongate shells, but instead merely discloses nesting cups (cup members 12). Claim 28 further requires adjustable stops that are "effective to hold each extendable elongate shell at a selected level of extension."

The Examiner alleges the elements 13 and 14 of the Thibodeaux patent constitute stops and that it would be obvious to supply adjustable stops. However, as previously explained, the Thibodeaux patent describes the elements 13 and 14 as a longitudinal U-shape groove 13 and a U-shape protrusion 14. The Thibodeaux patent goes on to state that the groove 13 and protrusion 14 prevent "each cup member from rotating relative to the others." (Col. 2, lines 39-46). Thus, while these elements 13, 14 may act as radial stops that prevent rotation of cups members 12 relative to each other, these elements 13-14 certainly do not act as stops or adjustable stops that could "hold each extendable elongate still at a selected level of extension," as required by claim 28.

Thus, even if these radial stops that prevent rotation of cups members 12 relative to each other were made “adjustable” in accordance with the Examiner’s suggestion, the Thibodeaux fisherman’s cooler incorporating these “adjustable” radial stops would still lack the adjustable stops defined in claim 28 that are “effective to hold each extendable elongate shell at a selected level of extension” and consequently would not equal the invention of the above-identified application, as defined in claim 28. This demonstrates that the Examiner has failed to establish *prima facie* obviousness, since the Examiner has not shown that the prior art **compels** the modification the Examiner proposed. In re Spada, 15 U.S.P.Q.2d at 1657, n. 3. Indeed, making the modification proposed by the Examiner would actually be ineffective for achieving the Examiner’s desired result. Furthermore, Applicant notes there is no evidence of record that teaches, suggests, or motivates, as required by In re Fine, the Examiner’s suggested change to make the radial stops (elements 13, 14) adjustable. 5 U.S.P.Q.2d 1596.

Next, claim 29 reads as follows:

29. *The ice fishing tackle storage apparatus of claim 1 wherein each extendable elongate shell has a proximal end and a distal end, the proximal end of each extendable elongate shell having a rounded surface that is adequate to minimize abrasion of any fishing line that rests against the proximal end of any extendable elongate shell.*

The Thibodeaux patent does specify that the cup members 12 are used to hold fishing rods. However, as depicted in Figure 1 of the Thibodeaux patent, the handles of the fishing rods are to be positioned in the cup members 12 that constitute part of the fishing rod holders 10. As previously explained, the cup members 12 have bottoms and therefore the handles of the fishing rods depicted in Figure 1 do not extend through the cups, but instead are merely held within the cup members 12. With this positioning, one of ordinary skill in the art of fishing equipment would readily understand that fishing line would actually extend from the depicted reels toward the tip of the fishing rods and away from the cup members 12. Thus, no fishing line would be in contact with the cup members 12 of the Thibodeaux fishing cooler.

Claim 29 specifies that each extendable elongate shell (such extendable elongate shells are not taught, suggested, or disclosed by the Thibodeaux patent) has a rounded surface to

minimize fishing line abrasion. The only conceivable way that fishing line could come into contact with the cup members 12 in a manner that could potentially cause abrasion would be if the tips of the fishing rods were somehow allowed to pass through the cup members 12 and into the cooler. However, the cup members 12, as detailed at length above, each have bottoms and therefor do not collectively constitute elongate shells. (Thibodeaux patent, col. 2, line 35-50, and Figs. 1 and 4). These bottoms of the cup members 12 would prevent the tips of the fishing rods from extending through the cups and into the cooler. Consequently, the cup members 12, and the associated bottoms of the cup members 12, would not allow positioning of ice fishing rods in a manner that would allow fishing line to come into contact with the cup members 12. Therefore, there is no motivation, as required by Uniroyal, Inc, whatsoever for rounding the tops of the cup members 12, since, the cup members 12 are not adapted to storing ice rods in a manner that would allow fishing line to come into contact with the tops of the cup members 12. 5 U.S.P.Q.2d 1434, 1438. Therefore, despite the Examiner's contentions to the contrary, it would not be obvious to provide rounded surfaces on the cup members 12 of the Thibodeaux fishing cooler.

Furthermore, Applicant fails to see how rounding the surfaces of ends of the cup members 12 of the Thibodeaux patent would make it easier to insert rod handles into a particular cup member 12, as depicted in Figure 1 of the Thibodeaux patent. There is simply no motivation from the Thibodeaux patent, based simply on this teaching of inserting rod handles into a particular cup member 12, to round proximal ends of the cup members 12. Instead, this is simply an example of hindsight reconstruction by the Examiner merely for the purposes for attempting to force elements into a reference, where the elements are neither disclosed nor taught by the reference. Such hindsight reconstruction using the claimed invention as a model for picking and choosing details to use in modifying a prior art disclosure is improper. See In re Fine, 5 U.S.P.Q.2d at 1600.

Additionally, Applicant notes there is no evidence of record regarding the Examiner's contention that "rounded surfaces are old and well known in fishing tackle storage devices." The Examiner takes "Official Notice" in support of this contention. Applicant has traversed this contention of the Examiner requested that the Examiner provide either independent documentary evidence, such as a publication, or an Affidavit expressing personal knowledge, regarding the

Examiner's allegation that "rounded surfaces are old and well known in fishing tackle storage devices." The Examiner has not yet complied with this request. Absent such evidence, there is clearly no basis for any teaching, suggestion, or motivation to rounding the tops of the cup members 12 in accordance with the Examiner's suggestion.

The Thibodeaux patent does not teach suggest, disclose, or render obvious the invention of the above-identified application, as defined in claims 28 and 29. Consequently, the Examiner erred in rejecting claims 28-29 under U.S.C. §103 based upon the Thibodeaux patent. Reconsideration and reversal of the rejection of claims 28-29 accompanied by allowance of claims 28-29 is respectfully requested.

VI.**The Wolniak patent, In View Of the Thibodeaux Patent, Does Not Render Claims 1, 4-6, 16, And 43 Obvious Under 35 U.S.C. §103.****A. Claim 6 is allowable because claim 6 depends from an allowable claim.**

The Examiner has alleged the Wolniak patent, in view of the Thibodeaux patent, renders claim 6 unpatentable under 35 U.S.C. §103. Claim 6 depends from independent claim 1 and further defines the ice fishing tackle storage apparatus. Since claim 6 depends from independent claim 1, the Examiner has failed to establish that the present invention, as defined in claim 6, is unpatentable over the Wolniak patent in view of the Thibodeaux patent. Consequently, the Examiner erred in rejecting claim 6 under U.S.C. §103 based upon the Wolniak in view of the Thibodeaux patent. Reconsideration and reversal of the rejection of claim 6 accompanied by allowance of claim 6 is respectfully requested.

B. The Examiner failed to establish motivation to modify details based on the Wolniak patent, in view of the Thibodeaux patent, effective to render claims 1, 4-5, 16, and 43 obvious under 35 U.S.C. §103.

The Examiner has alleged the Wolniak patent, in view of the Thibodeaux patent, renders claims 1, 4-5, 16, and 43 unpatentable under 35 U.S.C. §103. In support of this rejection, the Examiner stated:

The patent to Wolniak shows an ice fishing storage device for fishing tackle as discussed above. Wolniak does not show the elongate shells having an adjustable length, but does show tubes of different lengths. Thibodeaux shows adjustable length tubes 12-14. In reference to claims 1, 16, it would have been obvious to provide Wolniak with at least one adjustable length tube as shown by Thibodeaux for the purpose of storing fishing tackle of different lengths in one elongate shell. Thibodeaux shows a bucket 1, but does not disclose that the capacity is at least about three gallons. However, it would have been obvious to make the capacity at least about three gallons or whatever size is desired to best suit the purposes of the user. Routine experimentation would be used to determine the optimum size of the bucket. See *In re Jones* 162, USPQ 244. In reference to claims 4, 5, Wolniak shows a top wall 26 with apertures 22 which also can be considered sockets.

(Office Action dated 03/25/03, page 5, line 15, through page 6, line 5). However, despite the Examiner's statements in support thereof, the Wolniak patent, in view of the Thibodeaux patent does not teach, suggest, disclose, or make obvious the invention of the above-identified application, as defined in claims 1, 4-5, 16, and 43.

Claim 1 of the above-identified application reads as follows:

1. *An ice fishing tackle storage apparatus, the apparatus comprising:*
a pair of extendable elongate shells, the extendable elongate shells having an interior surface that defines an elongate cavity, the pair of extendable elongate shells located adjacent to each other, and ice fishing tackle capable of being positioned within the elongate cavity of each extendable elongate shell; and
a spacing structure, the pair of extendable elongate shells each secured by the spacing structure, the spacing structure effective to maintain the pair of extendable elongate shells in predetermined relation to each other, proximate the spacing structure.

Claim 1 thus defines an ice fishing tackle storage apparatus that comprises a pair of extendable elongate shells. The shells have an interior surface that defines elongate cavities within each shell and ice fishing tackle is capable of being positioned within each elongate cavity of each extendable elongate shell.

The Examiner characterizes the Thibodeaux patent as disclosing "adjustable length tubes 12-14." However, as explained above in connection with the Examiner's §102 rejection of claim 1 based on the Thibodeaux patent, the Thibodeaux patent does not in fact disclose any such "adjustable length tubes 12-14." Instead, the Thibodeaux patent discloses nesting cup members 12 of varying diameter. The Examiner alleges it would be obvious to substitute the alleged "adjustable length tubes 12-14" in the Wolniak patent "for the purpose of storing fishing tackle of different lengths in one elongate shell." However, substituting the nested cup members 12 in place of the tubes 30 of the Wolniak patent would not yield an adjustable length tube, but would instead yield the set of nested cups, where each cup would still have the bottom and an adjustable length cavity would therefore not exist. The nested set of cup members 12 from the Wolniak patent, even if inserted in place of the tubes 30 of the Wolniak tackle box, would therefore not collectively define an elongate cavity, as required by claim 1.

Furthermore, the nested set of cup members 12, even if inserted in place of the tubes 30 of the Wolniak tackle box, would not constitute the extendable elongate shells, that are required by claim 1. Thus, even if the nested set of cup members 12 from the Wolniak patent were inserted in place of the tubes 30 of the Wolniak tackle box in accordance with the Examiner's suggestion, this reconstructed form of the Wolniak tackle box would not equal the present invention, as defined in claim 1.

Additionally, even if the nested set of cup members 12 *were* disclosed as actually being tubes, instead of the nested cups that are actually disclosed, incorporation of such an adjustable length set of tubes in place of the individual tubes 30 disclosed in the Wolniak patent would destroy important and intended functions of the Wolniak patent. Specifically, as previously discussed, the Wolniak patent discloses cover portions 20a and 20b that are disclosed as confronting the open upper ends of the tubes 30 to help keep fishing lures in the cups 30 in the event the tackle box of the Wolniak patent is overturned. Any incorporation of extendable length tubes in place of the fixed length tubes 30 of the Wolniak patent would either prevent the covers 20 from being closed or would prevent the covers 20 from confronting the open ends of the tube. Either way, such incorporation of extendable tubes in the Wolniak tackle box would destroy an important and intended function of

the Wolniak patent, namely, either the ability to close the covers 20 or the ability to prevent lures from tumbling out of the tubes 30 upon disruption of the Wolniak tackle box.

The foregoing comments clearly demonstrate that modification of the Wolniak tackle box in accordance with the Examiner's suggestion using the Thibodeaux set of nested cups is neither taught, suggested, disclosed or obvious, as required by Uniroyal, Inc. 5 U.S.P.Q.2d 1434, 1438. Thus, the Wolniak patent and the Thibodeaux patent, either separately or in combination, do not teach, suggest, disclose, or render obvious the invention of the above-identified application, as defined in claim 1. Consequently, claim 1 is believed allowable over this §103 rejection of the Examiner.

Next, we consider claim 4. Claim 4 depends from independent claim 1 and reads as follows:

4. (Amended) The ice fishing tackle storage apparatus of claim 1 wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the wall comprising interior surfaces that define a plurality of recesses in the wall or a plurality of apertures through the wall, the spacing structure comprising the recesses or the apertures of the wall, each extendable elongate shell passing through the apertures of the wall or positioned in the recesses of the wall.

Claim 4 thus requires a container with a wall, where the wall comprises "interior surfaces that define a plurality of recesses in the wall or a plurality of apertures through the wall," where "each extendable elongate shell either passes through the wall apertures or is positioned in the wall recesses."

The Examiner alleges that "Wolniak shows a top wall 26 with apertures 22 which also can be considered sockets." Additional discussion regarding the Examiner's characterization of the tackle box disclosed in the Wolniak patent is provided above in regard to the Examiner's §102 rejections based on the Wolniak patent. The Examiner's characterization of the element 26 as a "top wall" of the Wolniak container is erroneous. The container in the Wolniak patent is disclosed as the element 10, with side walls 11, end walls 12, and a bottom panel 13. (Col. 3, lines 10-14; and Figure 1). The elements 21, 26 are disclosed in the Wolniak patent as being panels of floatation material

that are added to the container, and preferably secured to the container, but are not part of the container itself. Instead, the proper focus of the Examiner would have been upon the side walls 11, the ends walls 12, or the bottom panel 13 of the container 10. However, none of the side walls 11, ends walls 12, or bottom panel 13 include any such apertures or recesses where the elongate shells pass through the apertures or are positioned in the recesses, as discussed above in regard to the Examiner's §102 rejections based on the Wolniak patent.

The Examiner's combination of the Wolniak patent in view of the Thibodeaux patent does not teach, suggest, disclose, or make obvious the recesses or apertures that are required by claim 4. Furthermore, Applicant notes that claim 4 requires the extendable elongate shell, as previously discussed in relation to claim 1. The Examiner's combination of the Thibodeaux patent with the Wolniak patent does not teach, suggest, disclose, or render obvious the extendable elongate shell, as additionally required by claim 4.

Consequently, the Wolniak patent in view of the Thibodeaux patent does not teach, suggest, disclose, or make obvious the invention of the above-identified application, as defined in claim 4. Therefore, claim 4 is believed allowable.

Next, claim 5, which depends from independent claim 1, reads as follows:

5. *The ice fishing tackle storage apparatus of claim 1 wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the spacing structure comprising a plurality of sockets, the sockets attached to the wall of the container, and the extendable elongate shells positioned in the socket.*

Claim 5 thus requires sockets that are attached to a wall of the container. As noted above, the Examiner equates the apertures 22 in the floatation material panel 26 with sockets. This characterization of the Examiner is erroneous on at least a couple of grounds. First, the apertures of the floatation material are not sockets, but are instead apertures. These apertures are positioned well above any other related surfaces, so there is not a combination of a surface abutting the aperture that would allow the apertures to function as a socket. Furthermore, claim 5 requires that the socket be attached to a wall. Here, the apertures are not attached to a wall; instead, it is the template or floatation material 26 that is attached to a wall of the container in the Wolniak device. Furthermore,

we again note that the Wolniak patent, as modified to include the nested set of cup members 12 from the Thibodeaux patent, does not include the extendable shells required by claim 5.

Thus, the Wolniak patent and the Thibodeaux patent, despite the Examiner's suggestion to the contrary, do not teach, suggest, disclose, or render obvious the invention of the above-identified application, as defined in claim 5. Therefore, claim 5 is believed to be allowable.

Claim 16 depends from allowable claim 10 and reads as follows:

16. The ice fishing tackle storage apparatus of claim 10 wherein the elongate shells each have a longitudinal axis, a length of at least one of the elongate shells selectively and reversibly adjustable along the longitudinal axis of the at least one elongate shell.

Claim 16 thus requires an elongate shell with a length that is selectively and reversibly adjustable along the longitudinal axis of the elongate shell. A combination of the nested set of cup members 12 from the Thibodeaux patent in place of the tubes 30 of the Wolniak patent would not yield such a selectively and reversibly adjustable length elongate shell, for reasons analogous to those previously discussed in relation to claim 1 above. Thus, the Wolniak patent, even if modified using the Thibodeaux patent in accordance with the Examiner's suggestion, would not equal the invention of the above-identified application, as defined in claim 16. From this alone, it is clear the Wolniak patent in view of the Thibodeaux patent do not teach, suggest, disclose, or make obvious the invention of the above-identified application as defined in claim 16.

Finally, rejected claim 43 reads as follows:

*43. A bucket assembly, the bucket assembly comprising:
a bucket, the bucket having a water-holding capacity of at least about three gallons and the bucket having a wall, the wall having a proximal end and a distal end and the wall having an interior surface;
a plurality of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell; and
a first spacing component, the elongate shells each secured by the first spacing component, the first spacing component in contact with the proximal end of the wall, in contact with the interior surface of the wall,*

*or in contact with both the proximal end of the wall
and the interior surface of the wall.*

In support of the rejection of claim 43 under 35 U.S.C. §103 based upon the Wolniak patent and the Thibodeaux patent, the Examiner seems to rely on the Thibodeaux patent only, specifically the water-holding capacity of the Thibodeaux cooler, without commenting on the relationship of the Wolniak patent to claim 43:

Thibodeaux shows a bucket 1, but does not disclose that the capacity is at least about three gallons. However, it would have been obvious to make the capacity at least about three gallons or whatever size is desired to best suit the purposes of the user. Routine experimentation would be used to determine the optimum size of the bucket. See *In re Jones* 162, USPQ 244.

(Office Action dated 03/25/03, last line on page 5 through page 6, line 4). However, the Thibodeaux patent does not teach, suggest, or disclose the invention of the above-identified application. Specifically, as explained above, the nested cup members 12 do not individually constitute an elongate cavity, as required by claim 43. Furthermore, due to the aforementioned observation that the cup members 12 are cups, and therefore have bottoms, the nested cup members 12, collectively, do not constitute an elongate shell, as required by claim 43. Consequently, the Thibodeaux patent, standing alone, does not teach, suggest, or disclose the invention of the above-identified application, as defined in claim 43.

Next, there is clearly no teaching, suggestion, or motivation to substitute the nested cup members 12 of the Thibodeaux patent in place of the tubes 30 of the Wolniak patent. Indeed, the Examiner has not alleged such a combination of details in support of the present rejection based on the Thibodeaux and Wolniak patents. Furthermore, even if the Wolniak lure display box were reconstructed to incorporate the cup members 12 of the Thibodeaux fisherman's cooler, such a reconstructed form of the Wolniak lure display box would not include the elongate shell required by claim 43, but would instead merely include the set of nested cups members 12, where each cup would still have the bottom and an elongate shell would therefore not exist.

Finally, there is clearly no teaching, suggestion, or motivation to substitute the tubes 30 of the Wolniak patent in place of the nested cup members 12 of the Thibodeaux patent. Indeed,

the Examiner has not alleged such a combination of details in support of the present rejection based on the Thibodeaux and Wolniak patents. Motivation to make such a reconstructed form of the Thibodeaux fisherman's tackle box is lacking, since such a modification would eliminate an important and intended function of the Thibodeaux fisherman's cooler, namely the ability of a fisherman to select a particular one of the cup members that has a diameter suitable for holding a particular fishing rod. Essentially, the different cup members 12 each have a varying diameter so that cups with a smaller diameter may nest in cups having a smaller diameter. This allows fisherman to remove those cup members 12 having a diameter smaller than the diameter of the rod desired to be held in the fishing rod holder 10 (see lines 35-37 in Col. 2 of the Thibodeaux patent), which is an important and intended function of the Thibodeaux fisherman's cooler. (Thibodeaux patent, col. 1, lines 30-37).

Furthermore, any combination of details from the Thibodeaux patent and the Wolniak patent would fail to teach, suggest, disclose, or make obvious the invention of the above-identified application, as defined in claim 43, for an additional reason. Specifically, claim 43 requires a "bucket." Neither the Thibodeaux patent nor the Wolniak patent teaches, suggests, discloses, or motivates the use of a bucket. Instead, the Wolniak patent pertains to conventional fishing tackle boxes with flip top lids, and not buckets. On the other hand, the Thibodeaux patent relates to ice chests and coolers, as opposed to buckets.

Claim 43 is believed allowable. The Wolniak patent in view of the Thibodeaux patent clearly does not teach, suggest, disclose, or make obvious the invention of the above-identified application as defined in claim 43.

The Wolniak patent in view of the Thibodeaux patent does not teach suggest, disclose, or render obvious the invention of the above-identified application, as defined in claims 1, 4-5, 16, and 43. Consequently, the Examiner erred in rejecting claims 1, 4-5, 16, and 43 under U.S.C. §103 based upon the Wolniak patent in view of the Thibodeaux patent. Reconsideration and reversal of the rejection of claims 1, 4-5, 16, and 43 accompanied by allowance of claims 1, 4-5, 16, and 43 is respectfully requested.

VII. The McEwen Patent Does Not Render Claim 20 Obvious Under 35 U.S.C. §103.**A. Claim 20 is allowable because claim 20 depends from an allowable claim.**

The Examiner has alleged the McEwen patent renders claim 20 unpatentable under 35 U.S.C. §103. Claim 20 depends from independent claim 19 and further defines the ice fishing tackle storage apparatus. Since claim 20 depends from independent claim 19, the Examiner has failed to establish that the present invention, as defined in claim 20, is unpatentable over the McEwen patent. Consequently, the Examiner erred in rejecting claim 20 under U.S.C. §103 based upon the McEwen patent. Reconsideration and reversal of the rejection of claim 20 accompanied by allowance of claim 20 is respectfully requested.

B. The Examiner failed to produce any suggestion or motivation to modify the details disclosed in the McEwen patent in a way that would render claim 20 obvious under 35 U.S.C. §103.

The Examiner has alleged the McEwen patent renders claim 20 unpatentable under 35 U.S.C. §103. In support of this rejection, the Examiner alleged:

The patent to McEwen shows a fishing pole holder and storage container that functions as an ice fishing storage apparatus as discussed above. In reference to claim 20, McEwen does not disclose positioning the ice fishing storage apparatus in a container. However, it would have been obvious to store the elongate shells and the spacing structure in the container when not in use for the purpose of minimizing storage space.

(Office Action dated 03/25/03, page 6, lines 7-11). However, despite the Examiner's statements in support thereof, the McEwen patent does not teach, suggest, disclose, or make obvious the invention of the above-identified application, as defined in claim 20.

Claim 20 depends from independent claim 19 and reads as follows:

20. *The ice fishing tackle storage apparatus of claim 19 wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the wall having a proximal end and a distal end and the wall having an interior surface, the spacing structure either in contact with the proximal end of the wall, in*

contact with the interior surface of the wall, or in contact with both the proximal end of the wall and the interior surface of the wall.

Claim 20 calls for the ice fishing tackle storage apparatus of claim 19 to be positioned in a container, where the container has a wall with a proximal end and a distal end along with an interior surface. Claim 20 additionally requires that the spacing structure previously defined in claim 19 be in contact with the proximal end of the wall, the interior surface of the wall, or both the proximal end and the interior surface of the wall of the container.

The Examiner simply alleges that it would be obvious to store the tubes and the spacing structure of the McEwen device in the container “when not in use for the purpose of minimizing storage space.” The Examiner’s comments seemingly disregard the spacing structure contact requirements with the wall that are defined in claim 20. Apparently, the Examiner is suggesting that the tubes, sleeves 20, 18, the legs 40, 42, and the elastic sleeves 34, 6 be disassembled and placed in the container 10.

However, there is no suggestion to somehow position the support structure components thereby disassembled in contact with the walls of the container 10. Clearly, the disassembled form of the McEwen apparatus would not equal the details required by claim 20. Certainly, it would not be obvious to force disassembled portions of the support structure to be in contact with the walls of the McEwen portable fish bucket. Indeed, the McEwen patent does not suggest any such disassembly. This is instead apparently only the suggestion of the Examiner. The McEwen patent instead suggests only minor disassembly with none of the components being stored in the container 10. (Col. 2, lines 43-54; and Figure 1). Thus, the McEwen patent actually teaches away from the Examiner’s suggestion of complete disassembly with component storage in the bucket 10.

Based upon the foregoing comments, it is clear the McEwen patent does not teach, suggest, disclose, or render obvious the invention of the above-identified application, as defined in claim 20. Therefore, Applicant believes claim 20 is allowable.

The McEwen patent does not teach suggest, disclose, or render obvious the invention of the above-identified application, as defined in claim 20. Consequently, the Examiner erred in

rejecting claim 20 under U.S.C. §103 based upon the McEwen patent. Reconsideration and reversal of the rejection of claim 20 accompanied by allowance of claim 20 is respectfully requested.

VIII. The Wolniak Patent Does Not Render Claims 35-36 Obvious Under 35 U.S.C. §103.

A. Claim 35 is allowable because claim 35 depends from an allowable claim.

The Examiner has alleged the Wolniak patent renders claims 35 unpatentable under 35 U.S.C. §103. Claim 35 depends from independent claim 34 and further defines the ice fishing tackle storage apparatus. Since claim 35 depends from independent claim 34, the Examiner has failed to establish that the present invention, as defined in claim 35, is unpatentable over the Wolniak patent. Consequently, the Examiner erred in rejecting claim 35 under U.S.C. §103 based upon the Wolniak patent. Reconsideration and reversal of the rejection of claim 35 accompanied by allowance of claim 35 is respectfully requested.

B. The Examiner failed to establish that the Wolniak patent renders claims 35-36 obvious under 35 U.S.C. §103.

The Examiner has alleged the Wolniak patent renders claims 35-36 unpatentable under 35 U.S.C. §103. In support of this rejection, the Examiner alleged:

The patent to Wolniak shows a fishing tackle storage system as discussed above. In reference to claim 35, it is not clear if Wolniak can store an entire ice fishing tip-up within the chamber, but it would have been obvious to size the chamber and to store whatever type of and size of fishing tackle desired such as a tip-up so the tip-up can be transported safely to the fishing location. In reference to claim 36, Wolniak does not show a rounded surface on the proximal end of the elongate shell, but it would have been obvious to employ a rounded surface for the purpose of easier insertion of the tackle into the shell. As stated above, the Examiner takes Official Notice that rounded surfaces are old and well known on fishing tackle storage devices.

(Office Action dated 03/25/03, page 6, lines 13-20). However, despite the Examiner's statements in support thereof, the Wolniak patent does not teach, suggest, disclose, or make obvious the invention of the above-identified application, as defined in claims 35-36.

Claim 35 depends from independent claim 34 and reads as follows:

35. *The ice fishing tackle storage system of claim 34 wherein the ice-fishing tip-up is capable of being entirely within the chamber.*

As indicated above in connection with the Examiner's rejection of independent claim 34 based upon the Wolniak patent under 35 U.S.C. §102(b), the Wolniak patent does not even disclose the chamber that is defined in claim 35. Furthermore, there is nothing in the Wolniak patent that teaches or suggests including such a chamber. The Examiner simply concludes that such a chamber exists. This must be an oversight on the Examiner's part that fails to consider the chamber defining details of claim 34. Nonetheless, it is clear the Wolniak patent does not teach, suggest, disclose, or make obvious the chamber that is required by claim 35 or, for that matter, sizing of the chamber that would allow an ice fishing tip-up to be positioned entirely within the chamber.

Next, claim 36 reads as follows:

36. *(Amended) An ice fishing tackle storage apparatus, the apparatus comprising:*

a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell; and
a first spacing component, the pair of elongate shells each secured by the first spacing component;
wherein each elongate shell has a proximal end and a distal end, the proximal end of each elongate shell having a rounded surface that is adequate to minimize abrasion of any fishing line that rests against the proximal end of any elongate shell.

Claim 36 thus requires the proximal end of each elongate shell have a rounded surface adequate to minimize fishing line abrasion.

The Examiner alleges it would be obvious to employ a rounded surface on the tubes 30 of the Wolniak patent for purposes of "easier insertion of the tackle end of the shell." However, Applicant fails to see how rounding the surfaces of ends of the tubes 30 of the Wolniak patent would make it easier to insert tackle into the tubes 30. Certainly, the Wolniak patent only teaches use of the tubes 30 for storing lures, not fishing rods or tip-ups. There is simply no motivation from the

Wolniak patent, based simply on this teaching of storing lures in the tubes 30, to round proximal ends of the tubes 30. Instead, this is simply an example of improper hindsight reconstruction by the Examiner merely for the purposes for attempting to force elements into a reference, where the elements are neither disclosed nor taught by the reference.

Additionally, Applicant notes there is no evidence of record regarding the Examiner's contention that "rounded surfaces are old and well known in fishing tackle storage devices." The Examiner takes "Official Notice" in support of this contention. Applicant traversed this contention and requested that the Examiner provide either independent documentary evidence, such as a publication, or an Affidavit expressing personal knowledge, regarding the Examiner's allegation that "rounded surfaces are old and well known in fishing tackle storage devices." To date, the Examiner has not complied with this request, so the Examiner's comments have no effect as evidence. Absent such evidence, there clearly can be no basis for any teaching, suggestion, or motivation to rounding the tops of the Wolniak tubes 30 in accordance with the Examiner's suggestion.

The Wolniak patent does not teach suggest, disclose, or render obvious the invention of the above-identified application, as defined in claims 35-36. Consequently, the Examiner erred in rejecting claims 35-36 under U.S.C. §103 based upon the Wolniak patent. Reconsideration and reversal of the rejection of claims 35-36 accompanied by allowance of claims 35-36 is respectfully requested.

IX.**The McEwen Patent, As Applied to Claims 19 and 23, and Further in View Of The Wolniak Patent, Does Not Render Claims 40 and 42 Obvious Under 35 U.S.C. §103.****A. Claims 40 and 42 are allowable because claims 40 and 42 each depend from an allowable claim.**

The Examiner has alleged the McEwen patent, as applied to claims 19 and 23, and further in view of the Wolniak patent, renders claims 40 and 42 unpatentable under 35 U.S.C. §103. Claim 40 depends from independent claim 19 and further defines the ice fishing tackle storage apparatus. Claim 42 depends from independent claim 23 and further defines the ice fishing tackle storage apparatus. Since claims 40 and 42 depend from independent claims 19 and 23, respectively,

the Examiner has failed to establish that the present invention, as defined in claims 40 and 42, is unpatentable over the McEwen patent, as applied to claims 19 and 23, and further in view of the Wolniak patent. Consequently, the Examiner erred in rejecting claims 40 and 42 under U.S.C. §103 based upon the McEwen patent, as applied to claims 19 and 23, and further in view of the Wolniak patent. Reconsideration and reversal of the rejection of claims 40 and 42 accompanied by allowance of claims 40 and 42 is respectfully requested.

B. The Examiner failed to establish that the McEwen Patent, as applied to claims 19 and 23, and further in view of the Wolniak Patent, renders claims 40 and 42 obvious under 35 U.S.C. §103.

The Examiner has alleged the McEwen patent, as applied to claims 19 and 23, and further in view of the Wolniak patent, renders claims 40 and 42 unpatentable under 35 U.S.C. §103. In support of this rejection, the Examiner stated:

The patents to McEwen and Wolniak show fishing tackle storage devices and have been discussed above. In reference to claims 40 and 42 it would have been obvious to provide McEwen with a template as shown by Wolniak for the purpose of storing fishing tackle in the container.

(Office Action dated 03/25/03, page 7, lines 3-5). However, despite the Examiner's statements in support thereof, the McEwen patent and Wolniak patents, either separately or in any combination, do not teach, suggest, disclose, or make obvious the invention of the above-identified application, as defined in claims 40 and 42.

Claim 40, which depends from independent claim 19, reads as follows:

40. The ice fishing tackle storage apparatus of claim 19 wherein the spacing structure comprises a template, the template comprising a plurality of interior surfaces, the interior surfaces defining a plurality of apertures that extend through the first template, at least one of the elongate shells passing through one of the apertures of the template.

Claim 40, by virtue of its dependence from claim 19, thus requires the template along with elongate shells that extend through the template.

The Examiner does not suggest there is any teaching to move the tubes 30 from the Wolniak fishing lure storage box to the interior of the McEwen container. Therefore, even if the Examiner's suggestion of moving the Wolniak template to the McEwen container is done, the result in combination would not equal the invention of the above-identified application, as defined by claim 40, since the resulting combination structure would lack the elongate shells that are also required by claim 40 to pass through the templates. Similar comments apply with regard to claim 42 that likewise requires at least one elongate shell passing through the template. Furthermore, moving the templates of the Wolniak patent into the McEwen container in accordance with the Examiner's suggestion would hinder an important and intended function of the McEwen fishing device, namely the storage of water in the McEwen container for purposes of stabilizing the container.

Indeed, even if the Examiner had alleged that it would be obvious to move both the templates and the tubes 30 from the Wolniak patent into the McEwen container, such a move is not taught by either the McEwen reference or by the Wolniak reference. First, such a move would destroy an important and intended function of the Wolniak patent of providing a fishing tackle box that allows ready access to fishing lures by fishermen, since the bucket of the McEwen reference is much deeper than the fishing tackle box of the Wolniak patent and would essentially bury the Wolniak tubes 30 deep in the McEwen bucket. On the other hand, such a transfer of the tubes 30 and templates from the Wolniak tackle box to the McEwen bucket would destroy an important and intended function of using the McEwen device for holding the fishing tackle outside of the container and would likewise inhibit or even destroy the ability to place water in the McEwen bucket for purposes of stabilizing the McEwen device. (McEwen patent, col. 4, lines 42-44).

The McEwen patent and Wolniak patents, either separately or in any combination, do not teach suggest, disclose, or render obvious the invention of the above-identified application, as defined in claims 40 and 42. Consequently, the Examiner erred in rejecting claims 40-42 under U.S.C. §103 based upon the McEwen patent, as applied to claims 19 and 23, and further in view of the Wolniak patent. Reconsideration and reversal of the rejection of claims 40 and 42 accompanied by allowance of claims 40 and 42 is respectfully requested.

X.

Conclusion.

For the foregoing reasons the Examiner erred in rejecting claims 1-43. Reconsideration and reversal of the rejections of claims 1-43 accompanied by allowance of claims 1-43 are respectfully requested.

Respectfully submitted,

KINNEY & LANGE, P.A.

By:



Philip F. Fox, Reg. No. 38,142
Suite 1500
625 Fourth Avenue South
Minneapolis, MN 55415-1659
Phone: (612) 339-1863 Fax: (612) 339-6580

PFF:pff

Appendix A

CLAIMS ON APPEAL (1-43)

1. An ice fishing tackle storage apparatus, the apparatus comprising:
a pair of extendable elongate shells, the extendable elongate shells having an interior surface that defines an elongate cavity, the pair of extendable elongate shells located adjacent to each other, and ice fishing tackle capable of being positioned within the elongate cavity of each extendable elongate shell; and
a spacing structure, the pair of extendable elongate shells each secured by the spacing structure, the spacing structure effective to maintain the pair of extendable elongate shells in predetermined relation to each other, proximate the spacing structure.
2. The ice fishing tackle storage apparatus of claim 1 wherein the spacing structure comprises a first template, the first template comprising a plurality of interior surfaces, the interior surfaces defining a plurality of apertures that extend through the first template, each extendable elongate shell passing through one of the apertures of the first template.
3. (Amended) The ice fishing tackle storage apparatus of claim 2 wherein the spacing structure further comprises a second template, the second template comprising one or more interior surfaces, the one or more interior surfaces defining at least one aperture that extends through the second template, one of the extendable elongate shells passing through the aperture of the second template.
4. (Amended) The ice fishing tackle storage apparatus of claim 1 wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the wall comprising interior surfaces that define a plurality of recesses in the wall or a plurality of apertures through the wall, the spacing structure comprising the recesses or the apertures of the wall, each extendable elongate shell passing through the apertures of the wall or positioned in the recesses of the wall.

Appendix A (Continued)

CLAIMS ON APPEAL (1-43)

5. The ice fishing tackle storage apparatus of claim 1 wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the spacing structure comprising a plurality of sockets, the sockets attached to the wall of the container, and the extendable elongate shells positioned in the socket.
6. The ice fishing tackle storage apparatus of claim 1 wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the wall having a proximal end and a distal end and the wall having an interior surface, the spacing structure either in contact with the proximal end of the wall, in contact with the interior surface of the wall, or in contact with both the proximal end of the wall and the interior surface of the wall.
7. The ice fishing tackle storage apparatus of claim 1 wherein at least one of the extendable elongate shells has a longitudinal axis and comprises a female elongate shell and a male elongate shell that is positioned within the female elongate shell, the male elongate shell selectively movable along the longitudinal axis relative to the female elongate shell or the female elongate shell selectively movable along the longitudinal axis relative to the male elongate shell.
8. The ice fishing tackle storage apparatus of claim 7 wherein the female elongate shell and the male elongate shell are each tubes.
9. The ice fishing tackle storage apparatus of claim 7 wherein the female elongate shell and the male elongate shell each have a cross-sectional shape, the cross-sectional shape selected from the group consisting of cylindrical, square, rectangular, triangular, and elliptical cross-sectional shapes.

Appendix A (Continued)**CLAIMS ON APPEAL (1-43)**

10. (Amended) An ice fishing tackle storage apparatus, the apparatus comprising:
 - a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity, at least one of the elongate cavities having a length that is adequate to accept a portion of an ice fishing rod within the at least one elongate cavity, the ice fishing rod having a tip and a handle, a reel or a line windup attached to the ice fishing rod proximate the handle, the portion of the ice fishing rod extending from a tip of the ice fishing rod to the reel or line windup;
 - a first spacing component, the pair of elongate shells each secured by the first spacing component; and
 - a second spacing component, at least one of the elongate shells secured by the second spacing component, the second spacing component spaced apart from the first spacing component.
11. The ice fishing tackle storage apparatus of claim 10 wherein:
 - the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the wall having a proximal end and a distal end and the wall having an interior surface; and
 - the first spacing component is either in contact with the proximal end of the wall, in contact with the interior surface of the wall, or in contact with both the proximal end of the wall and the interior surface of the wall.
12. The ice fishing tackle storage apparatus of claim 11 wherein:
 - the second spacing component is in contact with the interior surface of the wall.

Appendix A (Continued)

CLAIMS ON APPEAL (1-43)

13. The ice fishing tackle storage apparatus of claim 10 wherein the first spacing component comprises a template, the template comprising a plurality of interior surfaces, the interior surfaces defining a plurality of apertures that extend through the template, each elongate shell passing through one of the apertures of the template.
14. (Amended) The ice fishing tackle storage apparatus of claim 10 wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the wall comprising one or more interior surfaces that define a recess in the wall or an aperture through the wall, the second spacing component comprising the recess or the aperture, one of the elongate shells passing through the aperture of the wall or positioned in the recess of the wall.
15. The ice fishing tackle storage apparatus of claim 10 wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the apparatus further comprising a socket, the socket attached to the wall of the container, and one of the elongate shells positioned in the socket.
16. The ice fishing tackle storage apparatus of claim 10 wherein the elongate shells each have a longitudinal axis, a length of at least one of the elongate shells selectively and reversibly adjustable along the longitudinal axis of the at least one elongate shell.
17. The ice fishing tackle storage apparatus of claim 10 wherein the elongate shells each have a cross-sectional shape, the cross-sectional shape selected from the group consisting of cylindrical, square, rectangular, triangular, elliptical, and any of these cross-sectional shapes in any combination.

Appendix A (Continued)**CLAIMS ON APPEAL (1-43)**

18. The ice fishing tackle storage apparatus of claim 10 in which a pair of the elongate shells are located adjacent to each other and wherein:

the first spacing component is effective to keep the adjacent pair of elongate shells in predetermined relation to each other, proximate the first spacing component; or the second spacing component is effective to keep the adjacent pair of elongate shells in predetermined relation to each other, proximate the second spacing component.

19. An ice fishing tackle storage apparatus, the apparatus comprising:

a plurality of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity, and ice fishing tackle capable of being positioned within the elongate cavities of the elongate shells;

a spacing structure, the elongate shells secured by the spacing structure, the spacing structure effective to maintain two or more of the elongate shells in predetermined relation to each other, proximate the spacing structure; and

wherein at least two of the elongate shells are capable of serving as legs that will stably support the apparatus on a surface when the at least two elongate shells are positioned in contact with the surface, the spacing structure effective to prevent slippage of the at least two elongate shells with respect to the spacing structure.

20. The ice fishing tackle storage apparatus of claim 19 wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the wall having a proximal end and a distal end and the wall having an interior surface, the spacing structure either in contact with the proximal end of the wall, in contact with the interior surface of the wall, or in contact with both the proximal end of the wall and the interior surface of the wall.

Appendix A (Continued)

CLAIMS ON APPEAL (1-43)

21. The ice fishing tackle storage apparatus of claim 19 wherein the elongate shells each have a longitudinal axis, a length of at least one of the elongate shells selectively and reversibly adjustable along the longitudinal axis of the at least one elongate shell.
22. The ice fishing tackle storage apparatus of claim 19 wherein the elongate shells each have a cross-sectional shape, the cross-sectional shape selected from the group consisting of cylindrical, square, rectangular, triangular, elliptical, and any of these cross-sectional shapes in any combination.
23. An ice fishing tackle storage apparatus, the apparatus comprising:
a plurality of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity, and ice fishing tackle capable of being positioned within the elongate cavities of the elongate shells;
a spacing structure, the elongate shells secured by the spacing structure, the spacing structure effective to maintain at least two of the elongate shells in predetermined relation to each other, proximate the spacing structure; and
a plurality of legs that are capable of supporting the apparatus on a surface when the legs are positioned in contact with the surface, the plurality of legs attached to the spacing structure or to any of the elongate shells.

Appendix A (Continued)

CLAIMS ON APPEAL (1-43)

24. The ice fishing tackle storage apparatus of claim 1 wherein the pair of extendable elongate shells comprise:

a first extendable elongate shell having a first interior surface that defines a first elongate cavity, the first extendable elongate shell comprising a plurality of separable elongate shell components, each elongate shell component having an inner surface that defines an elongate cavity portion, the elongate cavity portions of each adjacent elongate shell component in communication with each other and the elongate cavity portions collectively forming the first elongate cavity; and

a second extendable elongate shell having a second interior surface that defines a second elongate cavity.

25. The ice fishing tackle storage apparatus of claim 1 wherein each elongate cavity is selectively and reversibly capable of being lengthened or shortened.

26. The ice fishing tackle storage apparatus of claim 1 wherein the pair of extendable elongate shells are each capable of simultaneously holding different ice fishing tackle items.

27. The ice fishing tackle storage apparatus of claim 26 wherein the different ice fishing tackle items are pre-rigged ice fishing rods, pre-rigged ice-fishing tip-ups, or a pre-rigged ice fishing rod and a pre-rigged ice-fishing tip-up, the ice fishing storage apparatus effective for preventing the different ice fishing tackle items from becoming entangled with each other when held within the extendable elongate shells.

Appendix A (Continued)

CLAIMS ON APPEAL (1-43)

28. The ice fishing tackle storage apparatus of claim 1 wherein each extendable elongate shell comprises an adjustable stop, the adjustable stops effective to hold each extendable elongate shell at a selected level of extension.
29. The ice fishing tackle storage apparatus of claim 1 wherein each extendable elongate shell has a proximal end and a distal end, the proximal end of each extendable elongate shell having a rounded surface that is adequate to minimize abrasion of any fishing line that rests against the proximal end of any extendable elongate shell.
30. An ice fishing rod storage apparatus, the apparatus comprising:
 - a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing rods capable of being individually positioned within the elongate cavities of the different elongate shells;
 - a first spacing component, the pair of elongate shells each secured by the first spacing component; and
 - a second spacing component, at least one of the elongate shells secured by the second spacing component, the second spacing component spaced apart from the first spacing component.
31. The ice fishing rod storage apparatus of claim 30 wherein the ice fishing rods are capable of being individually positioned within the elongate cavities of the different elongate shells with tips of the rods within the elongate cavities and with either the reels or line windups of the ice fishing rods or fishing line extending from the reels or line windups in contact with the elongate shells.

Appendix A (Continued)**CLAIMS ON APPEAL (1-43)**

32. An ice fishing tackle storage apparatus, the apparatus comprising:
a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell;
a first spacing component, the pair of elongate shells each secured by the first spacing component; and
a second spacing component, at least one of the elongate shells secured by the second spacing component, the second spacing component spaced apart from the first spacing component;
wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the wall comprising a one or more interior surfaces that define a recess in the wall or an aperture through the wall, the second spacing component comprising the recess or the aperture, one of the elongate shells passing through the aperture of the wall or positioned in the recess of the wall.

33. An ice fishing tackle storage apparatus, the apparatus comprising:
a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell;
a first spacing component, the pair of elongate shells each secured by the first spacing component; and
a second spacing component, at least one of the elongate shells secured by the second spacing component, the second spacing component spaced apart from the first spacing component;
wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the apparatus further comprising a socket, the socket attached to the wall of the container, and one of the elongate shells positioned in the socket.

Appendix A (Continued)

CLAIMS ON APPEAL (1-43)

34. An ice fishing tackle storage system, the ice fishing tackle storage system comprising an ice fishing storage apparatus, the apparatus comprising:

 a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell; and

 a first spacing component, the pair of elongate shells each secured by the first spacing component; and

 a first wall, the first wall attached to the first spacing component; and

 a container, the ice fishing tackle storage apparatus positioned in the container, the container having a second wall, the first wall and the second wall defining a chamber within the container, an ice fishing tip-up capable of being placed in the chamber.

35. The ice fishing tackle storage system of claim 34 wherein the ice-fishing tip-up is capable of being entirely within the chamber.

36. (Amended) An ice fishing tackle storage apparatus, the apparatus comprising:

 a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell; and

 a first spacing component, the pair of elongate shells each secured by the first spacing component;

 wherein each elongate shell has a proximal end and a distal end, the proximal end of each elongate shell having a rounded surface that is adequate to minimize abrasion of any fishing line that rests against the proximal end of any elongate shell.

Appendix A (Continued)

CLAIMS ON APPEAL (1-43)

37. An ice fishing tackle storage apparatus, the apparatus comprising:
 - a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell; the elongate shells each having both a distal end and a proximal end;
 - a first spacing component, the pair of elongate shells each secured by the first spacing component, the first spacing component having a distal surface and a proximal surface; and
 - a second spacing component, at least one of the elongate shells secured by the second spacing component, the second spacing component spaced apart from the first spacing component;wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a closed bottom end and an open upper end, the first spacing component positioned at the open upper end.
38. The ice fishing tackle storage apparatus of claim 37, wherein the proximal end of at least one of the elongate shells is flush with the proximal surface of the first spacing component.
39. The ice fishing tackle storage apparatus of claim 19 wherein the spacing structure is free of contact with the surface.
40. The ice fishing tackle storage apparatus of claim 19 wherein the spacing structure comprises a template, the template comprising a plurality of interior surfaces, the interior surfaces defining a plurality of apertures that extend through the first template, at least one of the elongate shells passing through one of the apertures of the template.

Appendix A (Continued)

CLAIMS ON APPEAL (1-43)

41. The ice fishing tackle storage apparatus of claim 23 wherein the spacing structure is free of contact with the surface.
42. The ice fishing tackle storage apparatus of claim 23 wherein the spacing structure comprises a template, the template comprising a plurality of interior surfaces, the interior surfaces defining a plurality of apertures that extend through the first template, at least one of the elongate shells passing through one of the apertures of the template.
43. A bucket assembly, the bucket assembly comprising:
a bucket, the bucket having a water-holding capacity of at least about three gallons and the bucket having a wall, the wall having a proximal end and a distal end and the wall having an interior surface;
a plurality of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell; and
a first spacing component, the elongate shells each secured by the first spacing component, the first spacing component in contact with the proximal end of the wall, in contact with the interior surface of the wall, or in contact with both the proximal end of the wall and the interior surface of the wall.

Appendix B ****

REFERENCES CITED BY THE EXAMINER
(Copies Are Attached)

- * U.S. Patent No. 5,131,179 to McEwen
- * U.S. Patent No. 4,311,262 to Morin
- * U.S. Patent No. 6,185,860 to Thibodeaux
- * U.S. Patent No. 4,827,658 to Wolniak

Appendix C ******TABLE OF CASES AND AUTHORITIES**
(Copies Are Attached)

<u>In re Bond</u> , 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990) .	18, 19, 23-27, 31, 33-34, 36-38, 42-44
<u>Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick</u> , 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984) .	19, 27, 28
<u>Ex parte Levy</u> , 17 U.S.P.Q.2d 1461, 1462 (P.T.O. Bd. Pat. App. & Int'l 1990) .	19, 27
<u>In re Rijckaert</u> , 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993) .	46
<u>In re Spada</u> , 15 U.S.P.Q.2d 1655, 1657, n. 3 (Fed. Cir. 1990) .	46, 48, 51
<u>In re Fine</u> , 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988) .	46, 48, 51, 52
<u>W.L. Gore & Assoc., Inc. v. Garlock, Inc.</u> , 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983) .	46
<u>Libbey-Owens Ford Co. v. BOC Group Inc.</u> , 4 U.S.P.Q.2d 1097, 1103 (D.N.J. 1987) .	46
<u>Northern Telecom, Inc. v. Datapoint Corp.</u> , 15 U.S.P.Q.2d 1321, 1323 (Fed. Cir. 1990) .	46
<u>Uniroyal, Inc. v. Rudkin-Wiley Corp.</u> , 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) .	46, 47, 52, 56

First Named Inventor: Philip F. Fox

Application No.: 09/502,701

-83-

Appendix D
EXHIBIT LIST
(Copy Is Attached)

Exhibit A Page 283, 10th ed. (Merriam-Webster, Incorporated 1993)